

IN THE
UNITED STATES
CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT

LOUIE J. ANTONSEN,

Plaintiff-Appellant,

VS.

C. C. HEDRICK, individually, and doing
business under the assumed name and
style of PAPER EXCELSIOR & PAD
COMPANY,

Defendant-Appellee.

UPON APPEAL FROM THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF OREGON

BRIEF FOR PLAINTIFF-APPELLANT

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Subject Index

	<i>Brief Page</i>
Statement of the Case	1
Assignment of Errors	3
Argument	
Part 1	7
The Antonsen Tearing Machine and Tearing Method in Suit.	
Part 2	12
Analysis of Evidence of Prior Use.	
Part 3	18
Rafter's Attempt to Establish Prior Use.	
Part 4	21
Defendant's Claim About Discs In Contact.	
Part 5	22
Defendant's Machine.	
Part 6	26
Foster's Machine.	
Part 7	27
Henderson's Machine.	
Part 8	29
Conflict Of Testimony About Rafter's Machine.	
Part 9	34
Early Users Of Excelisor.	
Part 10	36
Effective Date of Patent.	
Part 11	38
Analysis of Court's Opinion.	

Authorities Cited

Brief
Page

The Law.

Part 1. Burden of Proof	70
Part 2. Prior Use Must Be Understood	77
Part 3. Oral Testimony On Prior Use Not Reliable	87
Part 4. Invention vs. Mechanical Improvement	91
<i>Ajax Metal Co. vs. Brady Brass Co.</i> , 155 F. 409.....	80
<i>Anthracite Separator Co. vs. Pollock, et al</i> , 175 F. 108..	86
<i>The Barbed Wire Patent</i> , 143 U. S. 275.....	35, 70
<i>Boyd vs. Cherry</i> , 50 F. 279	62, 78, 83
<i>Beckwith vs. Malleable Iron Range Co.</i> , 175 F. 1001..	79
<i>Cantrell vs. Wallick</i> , 117 U. S. 689	72
<i>Carson vs. American Smelting & Refining Co.</i> , 11 F. (2d) 770, 4 F. (2d) 463, 293 F. 771.....	22, 62, 85, 89
<i>Chisholm et al vs. Randolph Canning Co.</i> , 135 F. 315 ..	81
<i>Chisholm vs. Fleming</i> , 133 F. 924	81
<i>Chisholm vs. Johnson</i> , 106 F. 191	82
<i>Deering vs. Winona Harvester Works</i> , 155 U. S. 286	71, 88
<i>Diamond Patent Co. vs. S. E. Carr</i> 217 F. 400	22, 39, 62, 73, 78
<i>Diamond R. Tire Co. vs. Con. Tire Co.</i> , 220 U. S. 428	60, 65, 92

	Brief Page
<i>Eibel Process Company vs. Minnesota & Ontario Paper Co.</i> , 67 L. Ed. 523, 261 U. S. 45	44, 72
<i>Expanded Metal Co. vs. Bradford</i> , 214 U. S. 366	92
<i>Lee vs. Upson & Hart Co.</i> , 43 F. 670	94
<i>Nelson et al vs. Ford Motor Co.</i> , 38 F. (2d) 1001	90
<i>Parker vs. Stebler</i> , 177 F. 210	72, 89
<i>Sneed & Company Iron Works vs. Behn</i> , 4 F. (2d) 942	36, 37
<i>San Francisco Cornice Company vs. Beyrle</i> , 195 F. 518	73
<i>Willard et al vs. Union Tool Co.</i> , 253 F. 48	36
<i>Wheeler & Willard Manufacturing Co. vs. Bole</i> , 227 F. 607	39, 74
<i>Ward Baking Co. vs. Hazelton Baking Co.</i> , 292 F. 202	77, 91
<i>Walker on Patents</i> (6 ed.) Sec. 109	36

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Defendant-Appellee.

No. 8235

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UNITED STATES FOR THE DISTRICT OF OREGON

BRIEF FOR PLAINTIFF-APPELLANT

STATEMENT OF THE CASE

This is a patent infringement suit brought by L. J. Antonsen, against C. C. Hedrick, individually, and doing business under the assumed name and style of Paper Excelsior & Pad Company, in the United States District Court for the District of Oregon.

The suit alleged infringements of Claims 1 and 2, being machine or apparatus claims, and Claim 7, being a method or process claim of United States Letters Patent No. 1,731,967, dated October 15, 1929, and issued on an application filed August 30, 1926, for "paper excelsior

machines." Title to the patent in suit is in the Plaintiff, the inventor. The suit was tried in Open Court before His Honor Judge James Alger Fee. The testimony in the case was taken by deposition in Seattle on April 6, and 7, 1933, and in Open Court in Portland, April 26, 27, 28, May 1, 2 and 3, 1933. This suit comes to this Court on the appeal taken by the Plaintiff from the final decree of December 13, 1935.

CLAIMS 1, 2 AND 7.

The three claims alleged to be infringed are as follows:

1. In a paper shredding machine, the combination of a pair of parallel and oppositely rotated spindles, each mounting a plurality of inter-metshing, bevel-edged discs, and means for bodily shifting the discs of either group in the axial direction of their spindles for the purpose of adjusting their spaced relation with the discs of the other group.
2. In a paper excelsior machine, the combination of a pair of oppositely rotated parallel spindles, each having a plurality of bevel-edged discs fixedly mounted thereon, the discs of said spindles inter-meshing with their edge sides adjacent but not touching, and means synchronized with the spindles for conveying and feeding the stock between said intermeshing discs.
7. The method of manufacturing paper excelsior and the like which consists of tearing sheets of paper stock into narrow strips and separating said strips and piling them in haphazard fashion.

Infringement

The Defendant has admitted infringement by the an-

swer filed in Opon Court. Paragraph VI of Defendant's answer (R. 10) is as follows:

"Defendant admits that he has, now is, and expects to continue to use in certain portions of the District of Oregon a paper excelsior machine for the purpose of manufacturing paper excelsior, which machine manufacturers the same by severing or tearing sheets of paper into relatively narrow strips, and separating them in a haphazard fashion, admits that he has, does and will continue to operate said excelsior machine without license or permission of Plaintiff herein."

This express admission by Defendant makes unnecessary any reference here to evidence of infringement. The decision of the trial court as explained later in this brief, also clearly establishes infringement of the machine, and method claims. Mr. McDougall's uncontradicted testimony (R. 153 to 158), together with Plaintiff's Exhibits 7 and 8, also establish infringement. (R. 148)

Assignment of Errors

The assignment of errors (R. 56) is in the usual form.

I.

The Court erred in dismissing Plaintiff's Bill of Complaint.

II.

The Court erred in holding that the Plaintiff, Louie J. Antonsen, was not the original and first inventor or discoverer of any material or substantial part of the thing patented by Letters Patent No. 1,731,967.

III.

That the Court erred in holding that Claude C. Rafter

was the original and first inventor of any material and substantial part of the machine disclosed and its operation and process as taught by said Patent No. 1,731,967.

IV.

That the Court erred in holding that the Rafter machines one of which is owned and operated by the Defendant herein, from the inception of power use thereon continuously down to the date hereof produced torn feather edged excelsior by passing multiple layers of newspaper or other suitable paper stock through a pair of parallel and oppositely roatated spindles, each mounting a plurality of intermeshing beveled edge discs, and that when fed four sheets or upwards of paper stock, there was a shifting of the upper spindle of discs so as to take them out of facial contact with the lower discs, and thereby producing torn paper excelsior.

V.

The Court erred in holding that a nut placed on the end of the upper spindle when turned adjusted the space relationship between the sets of intermeshing discs.

VI.

The Court erred in holding that the said Rafter machine, as early as August or September, 1923, manufactured paper excelsior by tearing sheets of paper stock in to narrow strips, and discharging them from the machine, and piling them in haphazard fashion.

VII.

The Court erred in holding that there is no difference between the paper excelsior first manufactured by said Rafter and that produced by Plaintiff Antonsen upon his invented machine.

VIII.

The Court erred in holding that the intermeshing discs of said Rafter's machines were so adjusted as to be not touching or in facial contact, but to have a one-thirty-secondth of an inch separation.

IX.

The Court erred in holding that said Rafter invented a machine upon which U. S. Letters Patent could have been secured.

X.

The Court erred in holding that said Rafter, through his own, or his attorney's oversight or inadvertence, failed to claim in his patent application what he was entitled to, and what was disclosed and visible in the actual machines constructed by said Rafter.

XI.

The Court erred in holding that the said Rafter machines manufactured paper excelsior of a kind and in the manner described in said U. S. Patent No. 1,731,967.

XII.

The Court erred in holding that the prints published in The Times newspaper on March 29, 1925, show the said Rafter machine manufactured paper excelsior by tearing and severing sheets of paper stock into narrow strips, separating said strips and piling them in haphazard fashion, and further in holding that said prints show the paper excelsior therein photographed as piled in a haphazard manner, and that the individual strips reveal rough feather edges.

XIII.

The Court erred in holding that the other machines contemporaneously manufactured by the said Rafter pro-

duced torn paper excelsior feather edged, and separated one from the other and piled in haphazard fashion, and in further holding that the excelsior discharged from said machines, as an inherent and characteristic attribute of said machines, was separated and piled in a haphazard fashion.

XIV.

The Court erred in holding that said Rafter machines were not operated with the contiguous intermeshing discs in facial contact, and in further holding that the said machines were not adjusted to so operate, and in further holding that in fact and in practice the said Rafter machines were adjusted to have a clearance or separation between the surface sides of the contiguous discs, and that such separation was intentionally made by the parties who understood the means and manner of making the same and appreciated said adjustment.

XV.

The Court erred in holding that it was a small and simple matter to adjust said Rafter machines so as to obtain the amount of desired separation between the surface edges of contiguous intermeshing discs, and a simple matter for an ordinary mechanic to make the upper spindle of said machines fixedly mounted instead of yieldably so.

XVI.

The Court erred in holding that Louie J. Antonsen, Plaintiff herein, purposely instituted suits in other jurisdictions geographically removed from the above entitled Court to avoid the defenses raised in the above entitled suit.

XVII.

The Court erred in holding that the evidence of the De-

defendant on the facts found by the Court is clear, unequivocal and convincing, and establishes defenses alleged in said Defendant's answer, and has sustained every burden of proof placed on said Defendant by clear, unequivocal and convincing evidence.

XVIII.

The Court erred in holding that Louie J. Antonsen, Plaintiff herein, invented nothing.

XIX.

The Court erred in holding that U. S. Letters Patent No. 1, 731, 967, issued to the Plaintiff herein, are void and of no force or virtue.

XX.

The Court erred in not rendering a decree in accordance with the physical exhibits admitted in evidence.

XXI.

The Court erred in not rendering a decision in accordance with the prayer of Plaintiff's Bill of Complaint.

XXII.

The Court erred in not holding that the machine and process taught by Plaintiff's patent in Claims 1, 2 and 7 of said patent in suit were infringed.

XXIII.

The Court erred in overruling Plaintiff's exceptions to Defendant's proposed Findings of Fact, Conclusions of Law and Decree.

Argument

PART I.

THE ANTONSEN TEARING MACHINE AND METHOD IN SUIT.

The evidence shows (R. 66) that the Plaintiff for several years before his invention was an employee of a daily

newspaper in Seattle, Washington. He was given all over-issue papers as a part of his compensation. He disposed of these as wrapping paper for fish markets; and even exported some to China. About 1920, he began to work on a paper excelsior machine to convert the waste paper into a commercial excelsior. In experimenting he made several such machines, all employing the old cutting method. While experimenting one day in 1924, his machine broke. In fixing it, and putting it back together, he left off the nut on one end of the spindle, and when paper was fed to the machine he noticed it went through faster, and he was able to feed more. Instead of the machine cutting six sheets, as before, it would tear forty sheets (R. 77). When the excelsior was ejected from the machine, it scattered all over, it curled and flew in different directions, instead of being straight and falling down in front of the machine as before.

He knew then the machine could produce more excelsior, and also a new kind. The edges of the excelsior, instead of being smooth and clean cut, as before, were now rough and ragged. Instead of being flat the excelsior was twisted and curled. In due time he discovered the cause of this phenomena. The intermeshing shredding discs (R. 76) instead of being in facial contact, and in a cutting relation as before, were now separated about one-thirty-secondth of an inch, and paper put through the machine was torn instead of cut.

Plaintiff then went to Robert L. Rockwell, Patent Attorney and Engineer (R. 77), and explained the invention he had conceived, and told Rockwell what had happened. He made a full disclosure to him on February 4, 1925. (R. 128-130) Additional experiments were conducted, and

in August, 1926, Plaintiff filed his patent application. The patent in suit was granted him on October 15, 1929.

Antonsen understood and appreciated his invention, and in his patent application set forth the following: (R. 71)

“My invention relates to improvements in shredding machines of the particular type adapted to manufacture paper excelsior from waste paper.

It has been customary heretofore to cut the paper into narrow strips or shreds by means of a machine consisting essentially of a pair of oppositely rotating, parallel shafts on which are mounted cutting disks intermeshed and in facial contact. The narrow paper strips cut by such machines have straight, sharp edges as the result of the true shearing action of the rotating cutter. In handling excelsior made of these strips, the sharp edges often cut the hands of the packer. Furthermore, the strips are so uniform and straight that such excelsior is found to “pack” and is less resilient than the wood excelsior.

Machines of the type mentioned have a comparatively small production capacity because of the inherent limitations in the cutting process, and in the method used to feed the material to the cutters.

The object of my invention is to provide improved means for the shredding of paper whereby the same is torn, instead of cut, into narrow strips or shreds, producing thereby irregular feathery edges.

A further object is to provide means for the separation of the shreds cut from multiple layers of paper and to prevent the same from winding about the disk spindles of the machine.

A final object is to provide an improved method

of manufacturing paper excelsior, whereby the production capacity of the shredding machine is greatly increased over previous methods.”

Antonsen, Plaintiff's witnesses McDougall and Rockwell, engineers of great repute, in their testimony, explained the patent and great utility derived from said invention. The art of shredding multiple sheets of paper to make excelsior is old, dating back as far as 1885, but the testimony shows that paper excelsior was not recognized as a commercial product, and achieved no importance in the packing material field until Plaintiff Antonsen's product came on the market. (R. 79) So far as prior art is concerned, it had been confined to the cutting method. The improvement contained in the patent in suit consisted of tearing paper excelsior. Tearing paper instead of cutting it has two advantages, one of which (R. 78) is that the edges of the paper strips are rough, tend to interlock, and for that reason make a better and more resilient excelsior, and the same does not pack down; the other of which is, that tearing also puts fiber stress in the strip of paper, giving the strip a tendency to curl. (R. 77).

Antonsen further testified that the tearing process employed by his patented machine effects a corrugation of the paper fed to the machine, and that because of such corrugation the multiple sheets are torn one at a time, requiring less power than with the cutting method of forcing discs through multiple layers of solid stock. (R. 84) One of Plaintiff's experts, Mr. Rockwell, testified (R. 100-101) that the paper in passing through the intermeshing discs of Antonsen's machine was bent and corrugated before it is torn. That such bending and corrugating

greatly reduces the amount of force required to separate the fibers of the individual sheets of stock as they pass through the production head, whereas in the cutting process of the prior art, it had been necessary to sever the fibers by sheering or cutting them.

Antonsen testified that by the tearing method of his invention, paper excelsior is manufactured with one-half the labor, and at \$2.00 a ton less cost. (R. 77) Production is speeded up because of the increased capacity of the machines using the tearing method.

Torn excelsior was then introduced (R. 78) on the market in Seattle. Then it was shipped to San Francisco and Los Angeles in ton lots. Machines were placed in Cleveland and eastern cities. In 1930 a license was issued to the American Excelsior Corporation of Chicago for all the country except the three coast states (R. 79). A new industry was created.

The success of torn paper excelsior naturally caused inventors and others to give the matter serious thought, with a view to sharing in the reward Antonsen was legally entitled to. Cutting machines were eyed with a view to altering and changing them into tearing machines. After all, the process was relatively simple. The adjustment required by a cutting machine, to change it into a tearing machine, (R. 152) was to so space one spindle of the intermeshing cutting discs so that the disc edged sides no longer engaged or touched the edged sides of the opposite spindle of discs. This change altered the sheering, cutting relation of the discs, and changed it into a tearing one. Imitations of Plaintiff's patent appeared through the country, making infringement suits necessary. The Plaintiff, at the time of trial, had spent approximately \$40,-

000.00 in protecting and promoting his patent.

The patent in suit was litigated in a case entitled "Antonsen vs. Joseph Schermer", in the United States District Court for the Northern District of California, Southern Division, and was held valid and infringed. In the case of Antonsen vs. Winter Paper Stock Company, an Ohio corporation, in the United States District Court for the Northern District of Ohio, Eastern Division, the patent was likewise held valid and infringed. In another case, entitled "Antonsen vs. R. H. Rasmussen, individually and doing business under the name and style of Spokane Waste Paper Company," United States District Court, for the Eastern District of Washington, Northern Division, the patent was held valid and infringed. Claims 1, 2 and 7 were the prevailing claims.

The Trial Court, in view of the forgoing evidence of remarkable growth of a new industry following the introduction of the Antonsen machine, and the tearing method, properly found that there had been an invention, and a new industry developed. (R. 35)

But by some unaccountable means the trial court arrived at the conclusion that the Plaintiff was not the inventor, but that he had stolen the idea for his invention from one Claude C. Rafter.

This may be explained in part by the fact that the case was tried in April, 1933, but the decision not entered therein until December 13, 1935, a lapse of over two and one-half years.

PART II.

ANALYSIS OF EVIDENCE OF PRIOR USE.

In view of the Court's holding of prior use, we desire

to analyze Defendant's evidence upon which the Court based its finding.

Defense witness Claude C. Rafter testified that in 1923 he invented a machine and method to manufacture paper excelsior.

Mr. Rafter attempted to obtain a patent on his claimed invention, and filed application therefor on January 24, 1924, through a Mr. Bowen, Patent Attorney. R. 239)

This application was prosecuted for nearly five years, from January 24, 1924, to October 5, 1928, all without success. Exhibit 28 is Rafter's file wrapper. *It speaks volumes.* It establishes clearly, satisfactorily and beyond a reasonable doubt that Rafter invented nothing. It clearly establishes that Rafter, along with a score of other infringers, after observing the simplicity of Plaintiff's invention, now seeks to obtain the benefit thereof.

Rafter's file wrapper, Exhibit 28, is one of those exhibits which cannot be tortured or fabricated. It is a cold, merciless witness that is neither influenced by passion or prejudice, desire or friendship. Its accuracy does not depend upon a failing or faulty memory. Its mute testimony is not colored.

In his application, Mr. Rafter said in part,

"And a further object of the invention is to provide a machine for cutting paper into shreds in which an upper set of knives is resiliently held against a lower set."

In his specifications, Mr. Rafter describes his machine in part as follows:

"These knives are mounted on spindles, and arranged so that the flat surfaces at the tips of their cutting edges of one set will engage the similar flat

surfaces of another set.

In the twelve claims of his application, Mr. Rafter designates the machine for cutting paper, and the knives mounted on two spindles with the knives engaging the opposite knives, and being in facial contact and sheering relation.

All of the claims were rejected by the Patent Office, and in response, Mr. Rafter filed an amended claim. Again the machine is therein designated as a paper cutting machine, having discs with cutting edges, and being so constructed that the edges of the knives in one group engage the straight edges of the knives in the other group.

Mr. Rafter's Attorney, in response to the patent office action, said:

"It will be observed that the essential feature of this invention is in the fact that the cutting edges of the two groups of knives are resiliently held together, and the knives are made independent, so that each may be of exactly the same thickness, so that it will be possible to secure a *positive bearing surface against every knife.*"

This amendment was rejected by the Patent Office on May 7, 1925. Thereupon, through his attorney, Mr. Rafter filed a new amendment. Again the claim describes the Rafter machine as a paper cutting machine, with the discs or knives in contact. This claim was rejected by the Examiner on April 19, 1926.

Mr. Rafter filed a further amendment on September 23, 1926, consisting of five different claims, each of which describe the machine as a paper cutting device, with two spindles on which are mounted multiple discs with cutting edges or knives, and being so mounted that the straight

edges of the knives in one group engage the straight edges of the knives in the other group. All of these claims were rejected on January 22, 1927, by the Patent Office.

In response to this official action, Mr. Rafter's attorney wrote the Commissioner of Patents in part as follows:

"It is not contended that just to position one set of rotary cutters above another amounts to invention, but to provide a plurality of rotary discs having beveled edges forming knives *arranged in abutting relation with one set above the other* is a new and novel arrangement, and does provide utility and advantage as compared with the prior patents."

In response to an action of the Patent Office citing the patent of Berchtold & Burchardt as references anticipating Rafter's invention, Rafter's patent attorney said:

"The patents of both Berchtold & Burchardt merely disclose two groups of rotating knives, but as the edges do not engage or are resiliently held against each other they can hardly be considered as conflicting."

On October 5, 1928, a final attempt was made by Mr. Rafter to secure a patent, and a new claim was filed designating his device as a cutting machine, and the operation is described as

"The discs on each shaft being rigidly mounted to form a unit with each disc removable, and the cutting edges of the discs opposite to, engaging and overlapping the cutting edges of the discs in the other group on the other shaft."

Mr. Rafter testified that his patent application drawing was prepared by Mr. Bowen, his Patent Attorney; that Mr. Rafter (R. 282) sat down with Mr. Bowen, ex-

amined samples of excelsior, and figured it all out after the machine and its operation had been fully explained by Rafter to Bowen; what it did and how it produced paper excelsior, and the kind that it made. Mr. Rafter said his patent attorney understood. (R. 282) Mr. Rafter testified that he could read shop drawings, and blue prints (R. 287). That after the patent drawing was prepared he examined it, that he then read over the patent application, signed it, and swore to it.

Mr. Rafter further testified during the five years his application was prosecuted, he employed additional attorneys in Detroit, Michigan, to look into the matter. They examined the machine and the product in 1927. Thereafter, the application was pressed further, but the Patent Office finally rejected it, October 1928, as lacking invention.

It is difficult to comprehend how the trial court in the instant case could reach the conclusion that Claude C. Rafter was the inventor of the machine and the process described in Plaintiff's Patent Claims 1, 2 and 7, when the unimpeachable physical evidence of Rafter's patent application so clearly established Rafter's machine as cutting devices.

Mr. Rafter testified that on every machine built by him he placed a coil spring on the top shaft at the end of the roll. Even at the time of trial in 1933 he testified (R. 284) that the mechanical function of this spring was

"to keep the upper roll against the lower roll *in contact* so that it would draw the paper in."

Another item of physical evidence was (Exhibit H) a newspaper article which appeared in the Seattle Times on March 29, 1925. The article was the result of an inter-

view by a Times reporter with Claude E. Rafter, son of Claude C. Rafter. This article describes the machine as consisting of two rollers holding disc shaped knives with the two rollers set in the machine so that the knives, which are revolving with their cylinders, cut in a similar fashion as the blades of sheers. At least five times in the article, the word "cutting" is used to describe the operation of the machine and its product. Nowhere is anything said about tearing paper. Photographs of excelsior also appear in the article, and enlarged photographs of this excelsior are in evidence. Exhibits 16, 18, 19 and 21. This excelsior is clearly cut and not torn. This is a demonstrated fact, and no amount of oral testimony can change it. A machine manufacturing paper excelsior by the cutting method may produce here and there a strip of ragged edged excelsior. But a tearing machine could not under any circumstances, produce a single strip of straight edged excelsior. To cut excelsior the blades must be in facial contact. These photographs conclusively corroborate the statements of cutting excelsior contained in the Times article. They clearly brand the Rafter machine as a cutting machine.

It must be borne in mind that the testimony of Rafter was that he had sold the machine pictured in the Times newspaper article to Antonsen, and that it was the same as his standard machine, and embodied the principles of his invention. (R. 287) Rafter's patent application corroborates the Times newspaper article, and the Times newspaper article corroborates Rafter's patent application, although dated fourteen months apart. These physical exhibits, although dated January, 1924, and March, 1925, by their mute testimony, establish Rafter's machines and

alleged invention as cutting devices, and not tearing machines.

In view of this physical evidence, what justification is there of the trial court's finding that Rafter was misunderstood by his patent attorney?—That his patent application was wrong and did not reflect Rafter's true invention?

PART III.

RAFTER'S ATTEMPT TO ESTABLISH PRIOR USE.

When Mr. Rafter's deposition was taken in Seattle prior to the trial, he produced a box of excelsior (Defendant's Exhibit 5 for identification) which he swore was manufactured by his machine in the first months of 1924. (R. 289) When strips of excelsior (R. 321) were picked out of the exhibit, (R. 290, 292) which clearly had the year date 1931, printed thereon, and other items historically later than 1924, the witness attempted to explain this glaring discrepancy by stating that his offered exhibit 5 contained excelsior manufactured by him within the last few months before his testimony on deposition. (R. 295) Later, at the trial he produced excelsior, Exhibit EE, and testified (R. 226) that it was the old excelsior which he had manufactured in 1924, which he confused with excelsior contained in Defendant's Exhibit 5 for identification. Mr. Rafter then further produced Defendant's Exhibit FF as the remainder of the sample of old excelsior supposedly taken from the attic of his former garage. The physical appearance of Exhibit 5 for identification, and Exhibits EE and FF, is so entirely different that no witness, under oath, in good faith could confuse the two and swear that the excelsior in Exhibit 5 for identification was the excelsior in Exhibits EE and FF. Least of

all, an alleged inventor of torn excelsior.

On deposition, Mr. Rafter further testified that before going into the excelsior business he dealt in cookies, which came packed in wood boxes, that he added glass tops to these boxes, and upon going into the excelsior business he stored some of these boxes in the attic of his garage. That he packed excelsior around some glass, and about *a month or six weeks prior to the taking of the deposition* (R. 288) he was looking for something in the attic, and found the excelsior. At the trial, however, he testified he discovered the wooden box with the glass and excelsior in it *the day before the deposition* (R. 227) was taken, instead of a month or six weeks prior to the taking of the deposition, and testified on the trial that he fixed the day he found the old excelsior as follows:

“Well, I remember going down to the Court proceedings the next day.” “Yes, I am sure.” (R. 235).

When asked how he explained the conflicting statements Rafter replied (R. 236)

“I don’t know.”

As to the amount of excelsior found in the wooden box, Mr. Rafter at the trial testified that it was a couple of handfuls, and described it as about twice the amount of excelsior contained in the box marked Defendant’s Exhibit 5. An examination of the excelsior in Defendant’s Exhibit 5 for identification, and a comparison of the same with Defendant’s EE and FF will establish further inaccuracy of Mr. Rafter’s testimony, and establish further that Mr. Rafter did not produce all of the excelsior found in the wooden box. (R. 236)

What became of the remainder of the alleged old excelsior? Mr. Rafter testified (R. 231 and 237) he ex-

amined it before he produced it in Court, very thoroughly strip by strip, looking for dates. The witness' thorough examination before it was produced in Court establishes conclusively that *he did not know when the excelsior was manufactured*. He did not want to get caught in another lie.

He knew the importance of the testimony, and believed he could break down Plaintiff's patent by producing excelsior supposedly manufactured in 1924, because he had discussed the question with Mr. Mitchell, a patent attorney representing a Longview, Wash., Paper Company, and had gone with Mr. Mitchell to secure affidavits to be used by Defendant in this case concerning the kind of paper excelsior manufactured by the early Rafter machine. (R. 330 & 331) He was interested in breaking Antonsen's patent, because he was again in the excelsior business and desired to use the advantageous tearing method, and having been sued for infringement for using the tearing method, his personal interests would be advanced by such testimony. (R. 320.) He testified that the wooden box was not brought into Court because it was all dusty and dirty, and he wanted it in a cleaner box, but he failed to produce the alleged wooden box either at the depositions taken in Seattle, which continued two days, or the trial in Portland, although that trial continued five and one-half days. It is an irresistible conclusion, that if the paper excelsior in Defendant's Exhibit 5 for identification was manufactured by Mr. Rafter, as he claims, it could not have been manufactured until March, 1933, because when the depositions were taken in April, 1933, Mr. Rafter testified (R. 320) he had only engaged in manufacturing paper excelsior for about thirty days.

Is the testimony of Mr. Rafter reliable? Does it measure up to the requirements of clear satisfactory proof, and be yond all reasonable doubt? No! It is replete with falsehoods and contradictions.

PART IV.

DEFENDANT'S CLAIM ABOUT DISCS IN CONTACT

In order to avoid any chance of the Court reaching the conclusion that Rafter's early machine was a cutting machine with the discs in facial contact, counsel for the Defendant adroitly asked each witness who viewed the early operation of Rafter's machine if there was any grinding noise coming from the discs, if the discs emitted any sparks, or if they were ever lubricated or greased.

Mr. Rafter, as well as Mr. Givnan, Defendant's patent attorney, testified positively that if metal discs operated in engaging and facial contact without lubrication, they would emit sparks, would heat and melt down in a day's run.

Notwithstanding this astounding bit of testimony, the uncontradicted evidence, and the admission of the Defendant himself about the Defendant's machine was that at the time of trial, two of the upper discs were in facial contact with two of the opposite discs on the lower spindle. Strange as it may seem, the facial contact of these two sets of discs carried the entire load of Defendant's machine, and the same has been operating over an indefinite period of time, without emitting sparks, grinding noises, being lubricated, heating or melting down. Other known excelsior machines on the present market, including the Blumfeldt & Rapp machine, testified to in the instant case, employ the cutting principle, and operated day in and day out with the metal discs in facial contact, without the dire

consequences suggested by defense counsel' adroit questions.

Why was Mr. Rafter so able to convince the trial court by his oral testimony in 1933, that metal discs in such contact could not last a day, without having been able to explain that to his patent attorney, Mr. Bowen, in 1924, when his patent application was being prepared. Why did he incorporate into the claims of his application *in express language* the very principles which he now testifies to as an impossibility? The case of *Diamond Patent Co. vs. S. E. Carr*, (CCA. 9) 217 F 400 is decidedly in point.

Is not his present testimony tainted with the apparent desire to reap the benefit of Antonsen's patent, by claiming that the principles of Antonsen's patent are what he had in mind in 1924 when he made his patent application?

In this connection, the statement of Justice Brown of the Ninth Circuit Court of Appeals, is apt, as quoted in the case of *Carson vs. American Smelting and Refining Company*, 11 F. (2d) 770;

"The frequency with which testimony is tortured or fabricated outright to build up the defense of a prior use of the thing patented goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer."

PART V.

DEFENDANT'S MACHINE.

Defendant's machine is the device allegedly infringing Plaintiff's machine and process patent.

This machine was constructed by Claude C. Rafter in Seattle. It was one of seven standard machines, which he claimed to have manufactured and sold. Purchased in Seattle by Mr. Wheeler, it was moved to Portland.

Mr. Wheeler operated it from sometime in 1924 to 1929. About 1929, Mr. Wheeler sold the machine to the Defendant, Mr. Hedrick, who operated it from 1929 to the time of trial.

Mr. Wheeler was produced as a Defendant's witness, and testified that he had purposely examined the machine the day before the trial to see if any changes or alterations had been made. He testified positively that it was in the same condition then as it was in 1924. The Trial Court went even further. In his opinion. (R. 31) The Court said:

"The *presumption* is the Defendant's machine now operated as it did when originally constructed."

Notwithstanding the presumption of the Court, and the testimony of Wheeler that the machine was unchanged, positive testimony was given by Defendants own witnesses, and the Defendant himself that the machine in question had been changed and altered from its original condition at the time of purchase from Rafter in 1924.

Wheeler testified that upon buying the machine in Seattle, he dismounted it for shipping, took the spindles out of their position in the frame, shipped the parts to Portland, and re-assembled the same in Portland. Mr. Wheeler testified that, about 1925, he had the nut taken off the end of the upper spindle of discs, and had a fly-wheel threaded and put back on in place of the nut to hold the spring in place. Then he added cross brace bars to form a fulcrum to rest the iron tool or file that he used to clear the clogged or jammed paper from between the discs. (R. 194, 195)

The Defendant, Hedrick, testified that he had the discs rebeveled and reconditioned. To do this they were taken

off of their spindles and then replaced. He further testified that the collars on the end of each of the spindles of discs sheered off. These collars had been attached by dolls or pins through the collar and sunk into the shaft. In replacing these collars, he had them shrunk on the shaft by heat, making them permanent. He apparently had this done twice, and testified (R. 203) that he was not present when the last collar was shrunk on, and that

“possibly the discs were taken off of the spindle at that time.”

He testified (R. 201) that the discs were taken off of the spindles and put back on when the discs were reconditioned and re-beveled. He further testified that he moved the machine from the old Wheeler location to a new location at which the device was found at the time of trial. He remained silent about taking the machine apart and re-assembling it.

Wheeler testified that the Defendant's machine, at no time he operated it between 1924 and 1929, had any of the discs in facial contact or cutting relation. He stated he had purposely examined the Defendant's machine the day before giving his testimony, to make sure that there was no change in the machine, and testified positively that there had been no change in any of the discs, that *none of the discs were in contact*. (R. 198).

In this testimony, Wheeler was clearly in error. This will be shown by testimony of various witnesses set out in a following paragraph, because two sets of the right hand discs as you face the machine were concededly in facial contact at the time of trial.

It appears that Mr. Wheeler's desire to testify favorably to Hedrick was so strong that his eyes could not see

the obvious thing that the Defendant admitted existed. At the time of giving his testimony, Mr. Wheeler still had \$110.00 of the unpaid purchase price due him from Defendant, Hedrick, for the machine.

It should be observed that changes and alterations in the Defendant's machine admittedly began in 1925, and continued to the time of trial. The alterations could have begun in 1924, when the machine was dismantled in Seattle.

Mr. Wheeler produced some excelsior, Exhibits Q and E at the time of trial, which he asserted were manufactured by him on Hedrick's machine in 1924. This excelsior was obtained from between the window casings of his old plant where he operated the machine from 1924 on. He particularly desired to show samples of excelsior, supposedly manufactured before Antonsen's date of disclosure of his invention to his patent engineer, Mr. Rockwell. He testified positively that he manufactured the excelsior, Exhibits Q and E and stuffed them in the rafters, (R. 197) in the winter of 1924, as winter weather insulation.

However, a strip of excelsior was extracted from the mass of excelsior which strip was traced to, and identified as having been cut from, a newspaper printed on June 13, 1925, Exhibit 25, (R. 238). By stipulation of counsel, it was agreed that said strip had appeared in the Portland Journal and had been printed June 13, 1925.

Such fact established that the excelsior, Exhibits Q and E, could not have been made in the year 1924. The newspaper was not published until June 13, 1925. The date of cutting that excelsior had to be subsequent to June 13, 1925. Incidentally, that would make the date of

manufacture of that excelsior subsequent to the date of disclosure of Antonsen's invention to Robert L. Rockwell, his Patent Engineer, (R. 128-131). Exhibits 23 (R. 225) 24, 26 and 27 likewise are bits of excelsior extracted from the mass claimed to have been stuffed in the wall by Mr. Wheeler in 1924. All of these exhibits show that they are strips of newspapers which were not published until 1925. Notwithstanding the fact that Mr. Wheeler testified positively that he placed the excelsior in the wall in 1924, and that *he could not be mistaken as to when he put it there, such testimony was clearly in error.*

Since the excelsior was placed in the wall as cold weather insulation, it would not have been placed there before the winter of 1925.

It should be noted that the series of alterations and adjustments on the Defendant's machine had begun before this date.

PART VI.

FOSTER'S MACHINE

This machine was another one of the seven machines manufactured by Mr. Rafter. It was purchased by Defendant's witness, Mr. Foster, who shipped it to Boston.

Upon its arrival there, he assembled it in the manner taught him by Rafter. He got down in front of the machine to look at the discs to see if it was going to run and cut paper.

"I could not see daylight between the discs." (R. 325) He further stated that his testimony was based upon the original set-up and occasional observation of the machine while it was running, before it started, and after it had stopped. (R. 325) The excelsior business was new to Mr. Foster. His manner of assembling the machine was

taught him by Mr. Rafter. In assembling it, he made sure the discs were in complete facial contact. The machine was to cut paper. (R. 324) He described the machine in his opinion as essentially a cutting machine. (R. 323) He stated the purpose of the spring was to hold the discs in contact, and that his machine could be fed between six to ten sheets. He further testified that his machine had sharpened discs, and that the opposite discs were in complete facial contact (R. 324). He abandoned the sale of excelsior in Boston because he was unable to make a go of it, and returned to Seattle, shipping the machine back.

Upon his return, he sold the machine to Mr. Antonsen, the Plaintiff, who purchased it in order that he could have a permanent sample of a cutting type of excelsior machine. That machine, as well as Plaintiff's entire excelsior and box plant, was destroyed by fire January 18, 1930.

However, Mr. Rockwell, Patent Engineer for Mr. Antonsen, examined Foster's machine after it was returned to Seattle, and experimented with it before its destruction. Mr. Rockwell corroborated (R. 94 and 95) the statements of Mr. Foster as to the mechanical function of the machine. He positively testified that all of the opposite discs were in facial contact, and that in his experiment with the machine it cut excelsior.

PART VII.

HENDERSON'S MACHINE

This was another one of the seven machines manufactured by Mr. Rafter. It was originally purchased from Mr. Rafter by Mr. Henderson, and shipped to San Francisco where it was operated for a period less than a year.

Mr. Henderson testified that the capacity of his machine was about six to ten sheets of paper (R. 300) at one time. If more were fed, the machine would choke and stop. This is in direct contradiction to his other testimony that the product of his machine was torn paper excelsior, for it is an undeniable fact that a machine using Antonson's tearing method accommodates forty sheets or better, without clogging, and that it is unnecessary to even sharpen the shredding discs.

Cutting knives are sharpened only that they may cut better. Sharpening is unnecessary in a tearing machine. What occasion was there to keep the discs sharp on Henderson's machine if they were not cutting paper excelsior? The necessity of keeping the knives of Rafter's machines in a sharp condition was a fact testified to by all of the operators of those machines, including Rafter himself.

In describing his machine, Henderson said (R. 301) there were two coil springs, one on each end of the upper shaft, to take up the vibration. The springs gave play to the upper shaft from end to end, if crowded too much on one side it would go to the other end, then the other way, would operate back and forth endwise.

Like Mr. Wheeler of Portland, Mr. Henderson adjusted his machine when it arrived at San Francisco. He made a big improvement (R. 300). This consisted of just a little suggestion of his own. He took the discs down to the machine shop and got leather fiber or paper fibre and cut a lot of little discs to go on the axel where the cutting discs go on, so as to separate them so much to broaden the width. Then he testified (R. 301) that sometimes he put two washers in one place, and sometimes he

put a paper in between the disc and the washer, both the paper and leather washer would go between the discs. (R. 301).

This testimony and the testimony of Mr. Wheeler suggests that Mr. Rafter's machine was not a complete success nor a completed product, but at the time the same was constructed by Rafter, was experimental only.

It should be noted that Mr. Henderson's description of the early machines does not agree with that given by other operators. In fact, his description is the fourth version of the mechanical construction and adjustment of Rafter's machines. Notwithstanding, Mr. Rafter testified that all of his machines were standard, uniform machines.

The remainder of the seven machines manufactured by Rafter were unaccounted for at the time of trial.

PART VIII.

CONFLICT OF TESTIMONY ABOUT RAFTER'S MACHINES.

Although supposedly constructed alike into seven standard machines, it is interesting to compare the conflicting testimony of the various operators of those machines.

The principal point of divergence in the testimony was, whether or not, the opposite shredding discs were in facial contact and cutting relation.

Plaintiff submits, that the overwhelming weight of evidence is in favor of Plaintiff's contention, that the opposite discs were in facial contact and cutting relation.

In support thereof, Plaintiff submits same is verified by;—

1. Rafter's patent drawings. These drawings, attached to Rafter's patent application, clearly show the opposite discs in facial contact. These drawings were prepared before Antonsen's invention and before any con-

troverly arose over Plaintiff's patent. Rafter testified that he could read blue prints, that he had fifteen years mechanical experience, that he could read shop drawings, that he examined these drawings and specifications, that he then signed and swore to them. They embodied his "invention" as he conceived it.

2. Rafter's patent specifications and claims. The wording of his specifications and claims could hardly be misinterpreted by anyone who could speak the English language. Time and again the word "engaging", "contact", "cutting relation", and similar words and phrases are used indicating a cutting process. These words and phrases were adopted and used by Rafter in his patent application at a time when there was no controversy with Antonsen. They were continuously used and adopted in the four and a half year fight with the Patent Office to obtain a patent. They were continued to be used after 1927, at which time Rafter employed additional patent counsel, who examined his machine and his product and patent application file. The prosecution of his application for a patent continued for over a year thereafter, without change of design or principle as exemplified by his original application.

3. Rafter's own testimony. Rafter testified, (R. 284) with reference to the facial contact of the discs, that the spring on the upper spindle of discs was put there "to keep the upper roll against the lower roll, in contact, so it would draw the paper in."

4. The Trial Court found that when a few sheets were fed to Rafter's early machine, that it cut the paper. This conclusion of the Court would hardly be reached or justified except that the discs of the machine manufacturing

such cut excelsior, would be in complete facial contact. Blades of sheers, when they are not in contact, cannot cut paper. The discs on a paper machine likewise cannot cut paper if not in contact.

5. Mr. Henderson testified that the discs were out of contact. It will be observed that this witness also testified there were two springs on his machine. Of course, this is contradicted by Mr. Rafter, Mr. Rafter's son, Mr. Wheeler, Mr. Antonsen, Mr. Foster, and Mr. Rockwell. Rafter's patent application and patent drawing also contradict this witness. Besides, it does not seem possible that this witness could observe that the discs of his machine had a fractional inch separation between them, as a minute part of their adjustment, when he was unable to observe accurately the presence of only one spring. The spring is a good sized device on the exposed end of the upper shaft.

6. Mr. Wheeler testified that the discs were out of contact on Mr. Rafter's original machines. He also testified that such was the condition of Defendant's machine at the time of trial. Defendant (R 203), Defendant's expert (R 218-219), as well as Plaintiff's (R 97-150-135) experts, all testified that two sets of discs on Defendant's machine were in facial contact. Mr. Wheeler's testimony is clearly inaccurate as to the condition of Defendant's machine at the time of trial. Also it is easy to conceive of inaccuracy in Mr. Wheeler's testimony as to the mechanical condition of Rafter's early machines, when he must search his memory for the past nine years to testify to the condition of the early Rafter machines.

7. Mr. Foster, Defendant's witness, testified that the discs were in facial contact. He explained why he knew

this. He said that he was sure they were in contact, because he got down in front of the machine to check it for operation in Boston. His explanation is the only logical one and the only one with the apparent earmarks of accuracy and understanding, of all of the operators of Rafter's early machines. Besides, Mr. Foster was corroborated in his statement by Mr. Rockwell, Patent Engineer, and by Mr. Antonsen, the Plaintiff, both of whom examined the discs on Foster's machine upon its return to Seattle.

8. The early Rafter machine that produced the excelsior photographed in Exhibit H, and other photographs appearing in the Times article of 1925, had to be a cutting machine in order to manufacture the type of excelsior pictured there.

9. Rafter's son, Claude E. Rafter, gave the interview for that Times article. That interview was given prior to any litigation over excelsior machines. It uses the word "cutting" throughout. It described a cutting process.

10. The Court intimated in that part of its opinion (R. 33), wherein the Court found that the early Rafter machines deviated from the patent application design by excessive use and wear, that the early machines had the discs in facial contact. The effect of the Court's holding is that the discs wore out of contact. The testimony of Mr. McDougall is called to attention (R. 168) to the effect that discs in a machine originally in contact would wear in contact and not wear out of contact.

The testimony about the capacity of the early Defendant's machines is fairly uniform. Henderson testified (R. 300) that the Seattle machine had a capacity of six to ten sheets. That his San Francisco machine (R. 298)

had a capacity of about twelve sheets. Foster testified that his Boston machine had a capacity of six to ten sheets. This is substantially verified by Mrs. Wright, (R. 332), who testified that the Rafter machine would accommodate about a half a newspaper.

The limited capacity of the early Rafter machines is a potent argument in establishing that those machines were cutting devices, for the uncontradicted testimony of the Plaintiff, and Plaintiff's experts, is that the tearing process accommodates forty sheets or better.

The limitation of capacity of the early Rafter machines is indelibly established in the memories of those witnesses who testified thereto, because, when fed in excess of the number of sheets testified to, the machines would jam, choke and stop. The laborious and difficult work of digging out the choked and jammed paper from between the discs impressed the limited capacity of the early Rafter machines upon the memories of those witnesses.

The attention of the Court is called to the testimony of Plaintiff's expert, McDougall, (R. 152) and Plaintiff's expert, Rockwell (R. 125 and 126) explaining how the Defendant's machine could have been changed from the cutting machine which it originally was, to the tearing machine that it had become at the time of trial. (R. 166) The testimony of Defendant's expert, Givnan, (R. 210) in his check-up of the Defendant's machine, showed the exact variations described by Plaintiff's experts as possible alterations of Defendant's machine.

With reference to the opinion of the Trial Court that the discs of the Defendant's machine became separated by wearing out of contact, Plaintiff desires to call the attention of the Court to the very pertinent fact that if such a

finding is correct, then there is no testimony in the record as to *just when such a worn out condition was attained by the Defendant's machine*. The burden of proof would rest upon the Defendant to establish that this worn out condition came into existence before the date of Plaintiff's invention; otherwise it would not and could not constitute *prior use*.

As a final observation on the conflict of testimony on the mechanical construction of Rafter's machines, Plaintiff makes this observation: *There is no testimony in the record to the effect that Defendant's machine with part of its discs in contact and part of the discs out of contact is the same mechanical construction as Rafter's other standard machines*. Defendant's machine in its present condition is an orphan so far as Rafter's seven standard machines are concerned. Although it is supposed to be one of the seven, its mechanical set-up is unique. It does not compare with Rafter's patent applications or drawings. It does not compare with his oral testimony. Nor does it compare with the testimony of any of the other operators of Rafter's standard machines.

PART IX.

EARLY USERS OF EXCELSIOR

Defendant produced certain early users of paper excelsior, all of whom admitted that they did not particularly examine the early excelsior used by them, but that the sample, Defendant's Exhibit 2, shown them, appeared to look like the excelsior they first used.

A typical example of the reliability of that kind of testimony is shown by the statement of one of such witnesses, a Mr. Palmer, when in response to a question whether the excelsior marked Defendant's Exhibit 2, was

like that first used by his company, the witness answered:

“During the period 1924-25 I did not examine the strips of excelsior to determine if the edges were straight or jagged, and I cannot now state whether the same were torn or cut in the process of manufacture. I do not recall the width of the strips of the excelsior then. I never paid any attention to the physical condition of the strips of excelsior, *but considered it only as packing material.*” (R. 317).

“Well, I will have to answer that question exactly the same as I did, in an honest way, that as far as the edges of the paper are concerned, as far as the width of the strips is concerned, *it was all paper excelsior to me.*” (R. 318).

The testimony of such witnesses needs no further comment. It should be observed, however, that the defense had in its possession throughout the trial the exhibit of alleged old excelsior produced by Wheeler. Instead of having alleged early users of paper excelsior identify that particular excelsior as the type sold to and used by them at first, the defense had them examine Defendant's Exhibit 2, which was excelsior manufactured by Rafter less than thirty days before the trial. Exhibit 2 was concededly manufactured by an infringing machine and process. *Not one user of early excelsior identified Wheeler's alleged old excelsior.* Wheeler, alone, identified it. All others testified to allegedly approximate copies. In many Supreme Court cases, including *The Barbed Wire Patent*, this practice of identifying models and reproduced copies of original articles has been declared unsound and such evidence rejected. This Circuit has adopted the same standards. (See Part III of statement of the law.)

PART X.**EFFECTIVE DATE OF PATENT.**

Antonsen's patent does not date from the date of the execution of his application, but from the time of discovery, disclosure and reduction to practice. *Walker on Patents* (6 ed.) Section 109. An oral description of an invention subsequently patented, to a person who understands the description and remembers it is sufficient. In the case of *Sneed and Company Iron Works vs. Behr*, 4 F. (2d) 942 and 943, the question was raised whether an oral description made by a patentee to his brother was a sufficient disclosure. The Court of Appeals of the District of Columbia, reversing the decision of the Assistant Commissioner of Patents, held the disclosure sufficient to meet the requirements of the law.

In the case of *Willard et al. vs. Union Tool Company*, 253 F. 48-51, the Ninth Circuit Court of Appeals, speaking through Judge Gilbert, held that the burden on the patentee to establish invention and disclosure is controlled by the ordinary rules of Courts of Law with respect to the burden of proof, and is required to establish his priority only by a fair preponderance of the evidence, and not by proof conclusive in character, or beyond a reasonable doubt.

The evidence in this case shows that on February 4, 1925, Antonsen made a full disclosure of his machine and process invention to Robert L. Rockwell, (R. 128-131) the man who prepared Plaintiff's application. Rockwell testified fully upon this point, giving a minute description of Plaintiff's machine covered by Plaintiff's patent, and also a description of the product and the method of making it. Rockwell testified the disclosure was so complete

as to have enabled him to construct the machine and produce the product. He made a memo of the date when Mr. Antonsen made the disclosure. That memo in (R. 128) writing was with him in Court at the time of giving his testimony.

Mr. Rockwell had a search made of the patent records to determine the novelty of Antonsen's inventions. (R. 88) This he could not have done without having fully understood Antonsen's inventions. That search was made in July, 1925.

Mr. Rockwell is an engineer of standing. (R. 86 and 87) He is licensed to practice as a patent solicitor. His testimony is unimpeached, and not in any way discredited. Antonsen submits, therefore, that his patent must date from February 4, 1925. The trial court apparently accepts that date. In his opinion he said

"by disclosure of essential features made by him in the United States, February, 1925" R. 30)

Snead & Co. Iron Works vs. Behn (CCDC)

4 F. (2d) 942-943.

"But where, as here, a party not only has disclosed the result to be achieved, but has definitely and fully disclosed the means for accomplishing that result, the only question for determination is whether the testimony of the witness to whom he made the disclosure meets the usual test as to credibility. In this case, Mr. Angus Macdonald is a witness of much more than average intelligence, a man of affairs, and, so far as this record discloses, of unimpeachable character. Speaking of his testimony, the Board said: "The testimony stands unimpeached in any particular, and there is nothing in any way to cast sus-

picion or doubt upon its truthfulness. We are therefore convinced that the disclosure of the invention was at least prior to September 27, 1919,"

"The invention, as already noted, is simple, and, to a man of the intelligence and experience of Angus Macdonald, easily understood. The testimony of this witness is consistent with the surrounding circumstances, and so direct and positive that it must be either discredited and rejected, or accepted in toto. But, as we have stated, the witness stands unimpeached and his integrity unchallenged. It results that appellant is entitled to a date prior to September 27, 1919, for conception and disclosure."

PART XI.

ANALYSIS OF COURT'S OPINION

For the convenience of the Court, in making the analysis of the Trial Court's Opinion, we have divided the opinion into small sections and quote the same in a slightly different setting. Our analysis is then made in each paragraph following the quotations from the Trial Court's opinion.

(R. 30)

"The principal issue in this case under the pleadings is, has the defense of lack of novelty been established by that degree of proof required by the law."

Plaintiff agrees with the Court in that the principal issue is whether or not the defense of lack of novelty has been established by the degree of proof required by law. In fact, that is the sole issue in this case.

(R. 30)

"Antonsen has been issued a patent by disclosure of the essential features made by him in the United

States, February, 1925. This grant carries with it a strong presumption of validity, in view of the fact that paper excelsior is a present commercial necessity, and of the fact that patent ability of the device has been decided favorably by two other federal courts. There seems to be little ground for contention as to those features, but the chief defense in this case is lack of novelty, which has never been previously litigated, in respect to this particular process or machine. The burden of proof to establish lack of novelty lies upon the Defendant and in the ordinary instance as required by many courts to establish this issue by evidence beyond a reasonable doubt."

The Ninth Circuit Court of Appeals has uniformly held that this defense must be established beyond a reasonable doubt. This holding has been adhered to in the circuit on many occasions. *Wheeler and Willard Manufacturing Company vs. Bole*, 227 F. 607; *Diamond Patent Company vs. S. E. Carr Company*, 217 F. 400.

(R. 30)

"However, the rule as to weight of the requisite evidence is somewhat relaxed where anticipation is probable."

In this case anticipation was only not probable, but highly improbable. To assume that it is probable flies directly in the face of the careful statements in Rafter's patent application filed in January, 1924, and persisted in unchanged as to principal of operation until it was abandoned in October, 1928. To assume that it is probable, is contrary to the weight of the evidence in this case, if we consider the disinterested testimony. It is also contrary to the description of the Rafter invention as given by Rafter's son for the interview published in the Times newspaper article, Exhibit H, under date of March, 1925. The statement in this interview was clearly uncolored, because no litigation was pending at that time. No justi-

fication for the claim of probable anticipation can be urged in view of the pictures of the excelsior that appeared as a part of the Times newspaper article. Those pictures clearly establish the excelsior manufactured by Rafter's machine at that date in March, 1925, as cut excelsior. The few strips of roughened edge excelsior that can be pointed out in those photographs cannot justify the Court's conclusion that anticipation by Rafter's machine of the tearing process was probable. A cutting machine can tear to some extent while it is impossible for a tearing machine to cut so much as one strip.

(R. 30-31)

"Where the evidence of prior attainment of the result consists not only of oral testimony but of documents and things which tend to establish this conclusion."

There are no documents which by themselves tend to establish this conclusion. The documents and things probably referred to by the Court are those which the Defendant and his witnesses claimed in their oral testimony to be in support of their conclusions. There are documents and things, exhibits in this case, consisting of Rafter's file wrapper and patent application, and the photographs and the article in the Times newspaper under date of March, 1925, which establish conclusively the opposite fact.

(R. 31)

"There has been exhibited a machine made originally by one Rafter sometime in 1923. This is the alleged infringing device. It has been in continuous operation ever since it was sold by Rafter in 1924. The presumption is that the Defendant's machine operates now as it did when originally constructed."

The Plaintiff does not understand upon what possible theory of law or fact that permits the Court to indulge in such a presumption, especially in view of the admission of the Defendant that he has changed and altered the machine. When the original collars on the shafts of the rollers sheered off, the collars were then shrunk on by heat, making them permanent. The discs were taken off of the spindles, re-beveled and reconditioned. Some of the bearings were replaced. Wheeler, the former operator of that machine, testified that he took the cylinders of discs out of the machine and then replaced them back in the same relative position; that he put a fly wheel on one end of the spindle, which replaced the nut holding the spring on the end of the upper shaft. These changes and alterations have taken place since 1925. It is doubtful if the Court is entitled to such a presumption about the Defendant's machine, even if there were no testimony about changes and alterations. But with such testimony of changes and alterations in the record, it is impossible to conceive of any justification for the Court's presumption.

(R. 31)

"It is contended that this presumption has been rebutted by the physical condition of the Defendant's machine. The Hedrick machine shows that the discs are not all in facial contact, and it is claimed that the changes from the original machine have been introduced after the discovery by Antonsen."

It is essential to note that the Rafter machine now operated by the Defendant has only two sets of the discs in facial contact. Rafter and none of the Defendant's witnesses contend that Rafter's machines were constructed with two sets of discs in facial contact, and the balance out of facial contact. It is an irresistible conclusion that

the Defendant's machine had to be changed to get into its present condition with two sets of discs in facial contact. No unprejudiced mind could read the testimony without reaching the conclusion that the Defendant's machine had been changed. The spring is still there and still working, urging these two discs together and acting as an effective means for determining the position of the remaining discs. The design of the Rafter machine calls for a spring on the upper shaft, the purpose of which, as detailed by Rafter, was to effectively urge all of the discs in facial contact to draw the paper in. Being unequally spaced, only a few of them, two to be exact, are urged in contact. The spring urging *all of the discs* in facial contact was continually argued before the patent office in his patent application as the element of inventive genius entitling Rafter to a patent.

(R. 31-32)

"The testimony of C. A. Wheeler, who purchased the Hedrick machine from Rafter, and operated it until 1929, must be given great weight. He swears it has always produced excelsior similar in quality to that which it now brings forth. He introduced excelsior from the interstices between the rafters of a building formerly occupied by him, which he testifies was placed there in the winter of 1924-5. While this may not be entirely accurate, the Court is convinced that these samples are quite old, and that it is thereby demonstrated that the Hedrick machine was producing this type of excelsior very early."

The Plaintiff admits that the excelsior referred to by the Court is probably old, but the testimony positively shows that it was not placed between the rafters until the winter of 1925. Strips of excelsior, Exhibit 25, taken from the mass of excelsior bore the date of June 13, 1925. The excelsior could not have been manufactured

until after the newspaper had been published. That fact, coupled with Wheeler's testimony that it was used as weather stripping in the cold weather, would place the date of manufacture not earlier than sometime in the fall of 1925,

Two essential things should be noted in that connection. First, Wheeler changed the machine by placing a fly wheel on one end of the spindles, allegedly in 1925 or 1926. This fly wheel was to replace the nut that held the discs firmly against each other on one of the spindles. This alteration could easily account for the change in the manufacture of excelsior from a clean-cut edge to a semi-cut and torn edge. Second, Antonsen made his disclosure of his patent machine and process, as clearly established by the evidence, and as found by the Court in February, 1925. Bearing these two points in mind, even if the Hedrick machine were producing a similar type of excelsior very early, such evidence does not establish prior use by the public before the date of Antonsen's discovery and disclosure.

(R 32)

"Many witnesses who had some opportunity for observation testify that the product has always been the same."

The testimony of the witnesses referred to by the Court, was given in 1933. The facts about which they were testifying, namely, the physical condition of the excelsior manufactured by Rafter was a thing that they had observed in the fall of 1923 and the spring of 1924. A lapse of nearly ten years.

It will be noticed that these witnesses mostly were neighbors who had a casual passing interest, or they were foremen of packing departments, or purchasing agents,

most of whom did not even personally handle the excelsior. Is it reasonably that these witnesses, approximately ten years after a casual observation of Rafter's early paper excelsior, are able to honestly and competently testify correctly to the physical condition of that early excelsior? Such testimony is of so little value and so unreliable, even though it may have been given with the best of intentions, that it is not worthy of consideration. In any event, it is not sufficiently strong to overcome that presumption accorded an inventor upon the issuance of a patent to him.

We are constrained to point out the words of Chief Justice Taft of the Supreme Court of the United States, in the case of *Ibel Process Company vs. Minnesota and Ontario Paper Company*, 67 L. Ed. 523, page 531.

"The oral evidence on this point (referring to the question of prior use) falls far short of being enough to overcome the presumption of novelty from the granting of the patent. The temptation in such cases, and the ease with which honest witnesses can convince themselves after many years, of having had a conception at the basis of a valuable patent, are well known in this branch of the law, and have properly led to a rule that evidence to prove prior discovery must be clear and satisfactory."

(R 32)

"The testimony of Rafter himself has been entirely disregarded, except where corroborated, since he has been discredited by the character of his testimony. Of course, this feature is not entirely controlling since the other evidence establishes the facts."

This part of the Court's opinion needs no comment,

but we have taken the trouble elsewhere in this brief to set forth some of the glaring discrepancies of his testimony, so that this Court may understand the true nature thereof. After listening to the testimony given in Court, and after carefully reading the testimony as printed, we are unable to find any evidence that would justify the Court in saying

“Other evidence established the facts”

other than highly improbable, unsubstantiated oral testimony.

(R 32)

“As the court reconstructs the situation from the evidence, Rafter lost an opportunity. Prior to the time that his original conception of paper excelsior was the result of cutting machines and had straight edges. The process by which it was produced was slow, and if quantity production was attempted, the result was a stoppage.”

The testimony of the former operators of Rafter's machines is that the exact result, stoppage, occurred in the operation of his machines. The testimony of Henderson, who operated a Rafter machine in San Francisco, of Mrs. Wright who operated a Rafter machine in Seattle, and Wheeler who operated the Defendant's machine in Portland, and Rockwell, who tried Foster's machine after it had been returned to Seattle, Defendant's witness, Mr. Simpson, who operated Rafter's machine in Seattle, all testified to Rafter's machine becoming jammed, clogged and stopping. In fact, one of the early changes on Rafter's machine, as made by Wheeler, was the erection of an iron bar in front of the cutter upon which to rest a file that could be used to gouge out the paper excelsior that jammed between the cutting discs. Henderson testified

that his machine in California became clogged and it was necessary to shut the machine down and sometimes loosen the nuts that held the discs together, in order to take the jammed paper out from between the cutting discs. Mrs. Wright testified that she was unable to remove the paper jammed between the discs, and that she had to call Mr. Rafter, or his son in to clean out the jammed paper. One of the outstanding features of the old type cutting machine was the stoppage referred to in the Court's opinion. This stoppage was an outstanding feature of Rafter's machine.

(R 32)

"Rafter designed a cutting machine with the edges of the discs in facial contact, but he included in his application two specifications which looked toward quantity production, but which negatived almost entirely his original plan. These were the spring which allowed the discs to draw out of facial contact, and the means for re-adjusting the discs in their relation to each other."

The purpose of the spring, as specified by Rafter in his patent application, was to permit a separation of the discs to allow a hard object to pass through. Otherwise, the purpose of the spring was to urge the discs into facial contact. This contention was consistently urged throughout Rafter's patent application. In fact, it is the one element of inventive genius upon which he so tenaciously sought to obtain a patent for four and one-half years.

(R 32)

"There was not exhibited any machine in which the faces of the discs were now in facial contact. The testimony was that such a result could only have been attained by the most careful workmanship

throughout the device and absolute precise machine work upon the discs themselves.”

In view of the fact that cutting machines with their discs all operating in facial contact have been on the market since 1885, is it not queer that if the construction of such a machine were so impossible that a tearing machine would have been discovered long ago?

(R 32-33)

“It was likewise made clear that in the machines constructed by him the discs actually did not so contact each other.”

It is difficult to understand how the Court can place itself on record with a statement of this kind, in the face of Rafter's patent application, coupled with his oral testimony given in 1933, to the effect that the discs were maintained in facial contact for the purpose of drawing the paper in, and further in the face of the testimony of Mr. Foster, one of the Defendant's own witnesses, and a former owner of one of Rafter's machines, and the testimony of Mr. Rockwell, Plaintiff's expert who also examined Foster's machine, both of which witnesses testified definitely that Rafter's machine built in the spring of 1924 and purchased by Foster and later sold to Antonsen had its discs in facial contact.

(R 33)

“This point is hotly contested by the parties, but is of no particular value since all the evidence shows that under certain circumstances the devices constructed by Rafter did operate while these discs did not have the cutting edges in contact.”

It appears to the Plaintiff that the Court is contradicting himself on this point, for in the following paragraph in his opinion, the Court definitely states:

“The machine would cut paper with straight edges only if the sheets were fed a few at a time.”

This result could be achieved only by a machine operating with its cutting discs in facial contact.

(R 33)

“Whether by design or by careless construction, Rafter’s original exemplifications of the device did not fulfill his anticipation. The machine would cut paper with straight edges only if the sheets were fed a few at a time, and no great speed was attained. Dull as the discs are on the Hedrick machine, it will cut a sheet or two of trick glazed magazine paper today in this manner, and produce straight edges upon the strips. The original Rafter machine was operated by hand, and the action of the spring was thus not brought in to play. The Foster machine built by Rafter which was operated by hand power was exhibited by Antonsen to his attorney to illustrate the idea that the Rafter machines only cut paper, but if he had so operated is as to bring the spring into play by overcrowding, the result would have been different.”

If the Trial Court is unable to find any evidence upon which to base a conclusion that Rafter’s original exemplifications of his device did not fulfill his anticipations because of: 1. Change of design, or 2. Careless construction, it does not seem fair for the court to then proceed to find that prior use of a similar device invalidates a patent in suit, which was regularly issued by the United States Patent Office. It further does not seem fair for the trial court to include in his opinion the statement that the Hedrick machine will cut a sheet or two of trick glazed magazine paper today and produce straight edges upon the strips when there is no testimony in the record upon which such a conclusion of the court can rest, and saving the two discs in contact it is impossible. It further does not

seem fair that the court should include in his opinion statements with reference to the hand operation of Rafter's machines, in view of the uncontradicted testimony of Rafter and his son that the production of excelsior on their machines began the first of August, with no difference appearing in their excelsior, according to their testimony, from the inception, although they added power to their machine the middle of August. It would seem that the Court is going far into the realms of speculation, looking for some plausible explanation upon which to base an otherwise unsound opinion. Furthermore, it does not seem fair for the trial court to formulate his judgment upon the fact of "*overcrowding*" the Rafter machine. In other words, to justify his opinion, the trial court based the same upon not the usual and customary use of Rafter's machine, but upon an improper overfeeding and excessive strain which the machine was neither intended nor designed to accommodate. We wish to observe at this point that such improper overfeeding and straining of a machine could hardly be considered commercial success, and surely did not acquaint the public or any person with the tearing process.

(R 33)

"The experts for Plaintiff testify that the Rafter machine could not produce torn excelsior for the reason that it would jam as soon as it failed to cut the paper. The Court rejects this conclusion in the face of the direct evidence that it did not jam under such circumstances, and the direct evidence drawn from the actual operation of the Defendant's machine."

Expert Rockwell (R. 122) testified that paper fed to an excelsior machine such as the original Rafter machine, would have a tendency to wedge in between the discs as

they were pried apart by the thickness of the paper actuating the spring. He explained it by saying that this wedging action would be the same that resulted from taking a pair of shears and trying to cut several thicknesses of paper. If the shears are turned slightly, the edges will simply slip off. There is no cutting, and you do obtain a decided wedging action. It is easy to visualize this result occurring on the Rafter machine when it is fed multiple layers of paper sufficient in number that the discs are unable to cut the same, and they are accordingly forced apart as the blades of shears, multiplying the pressure of that forcing action by the ninety to one hundred discs that appear on the spindles of the Rafter machine. The Court will readily observe that the "stoppage" referred to by the Trial Court in his opinion when mentioning cutting machines, so definitely occurred in the Rafter machines. It is a mechanical truth that a cutting machine without a spring on one roll to permit a side wise movement would have less tendency to jam and stop, than the machine of Rafter's type that would so readily permit paper to wedge in between the discs because of the action side wise of the spring. This fact is again demonstrable by reference to cutting paper with shears. If the cutting blades of the shears are loosely held together by a pivot screw, they are more apt to pass by the paper and become jammed instead of cutting than are shears that are firmly held in facial contact by the pivot screw.

The Court rejects the above conclusion because of "direct evidence that it did not jam." Again, we wish to call the Court's attention to the abundant testimony of the Defendant's witnesses, as well as the Plaintiff's witnesses, that Rafter's machines did jam and we especially call the

Court's attention to the testimony of defendant's witness, Leonard E. Simpson, who operated Rafter's Seattle machine, (R. 309) as follows:

"If I fed more than four or five sheets at a time, about every fifteen minutes, the thing would clog up. Part of the paper would stick in the knives. You would have to shut down the machine, take a screw driver to jerk or grind out the paper from between the knives, either that or a rasp file. Of course, we would not have to shut the machine down to clean it out every time. Had a lot of trouble. Sometimes when the paper stuck, it would pull the pulley off, and you would have to work your fool head off trying to get the stuff out of between the discs."

"Generally, in order to stop it from clogging, you would only feed four or five sheets at a time."

"I worked there six months."

We also call the Court's attention to the testimony of defendant's witness Thomas E. Henderson (R. 300) who purchased Rafter's first machine and operated it in San Francisco.

"When I saw the Rafter machine in Seattle, it would take and run up to about six or seven sheets of paper at a time. If you would run more than that it would kind of choke and stop, sometimes you would roll back the fly wheel, roll the paper back. If there was any choked in there, take a hook or whatever we used for the purpose, and hold in between the discs and get the paper out. We used a piece of bent iron or a screw driver would do it. If you fed too many layers, or it was damp, she would choke."

We also call the Court's attention to the testimony of Mrs. E. G. Wright (R. 332) who operated Rafter's Seattle machine. as follows:

"I fed the paper to the machine. I had trouble operating the machine. When I fed the paper too thick, the machine would clog, stop running entirely. That happened as often as I fed too much paper."

We also invite the Court's attention to the testimony of defendant's witness Charles A. Wheeler, purchaser of one of Rafter's machines, and the seller of that machine to the Defendant, Hedrick, who testified as follows: (R. 196)

"I was present when the machine was operated for the Court's inspection the other day. I noticed a little retention of paper between the discs. That retention of paper was in two or three places, was not enough to clog the machine. One place was on the right hand end as you faced the machine, and another towards the left from the center. It is possible it clogged more toward the right hand end of the machine than any other place. When I operated the machine, it clogged once in a while. When I was operating the machine, *the clogging usually was general.*"

In view of this testimony, and other excerpts too lengthy to include in this brief, the Plaintiff challenges the accuracy of the Trial Court's rejection of the testimony of Plaintiff's experts, also the accuracy of the Trial Court's conclusion that the Rafter machine did not jam, when to do so he must also reject the weight of defendant's witnesses that it did jam.

It appears to the Plaintiff that it was improper for the

Trial Court to reject Plaintiff's expert testimony because of so-called "direct evidence drawn from actual operation of Defendant's machine," when that direct evidence is in the form of the Court's personal inspection of that machine in 1933, when the Court's frame of mind was such that he was presuming that that machine in 1933 was in the same condition as when it was manufactured by Rafter in 1924. This is especially true in view of the testimony of Wheeler and Hedrick, both being operators of that machine from 1924 to 1933, that they had changed and altered that machine. Furthermore, Wheeler testified that none of the discs were in facial contact when he operated the machine, while Hedrick admitted that two of the discs were in facial contact at the time of the Court's inspection.

(R 33)

"Whether the Rafter machines were constructed according to design or not, they were subject to deviation therefrom as a result of use. The dulling or chipping of the cutting edges of the discs, the weakening of the spring, or the shifting in alignment of the discs themselves, due to the failure to keep the nuts tight, or due to the difference in the thickness of the washers between them alike would change the essential character of the operation and of the product."

As we construe the remarks of the Court in the preceding paragraph, the Court, in effect says that the Rafter machines although constructed as cutting machines, the inaccuracy thereof, the wear and weakening of the parts and the lack of uniformity of the parts of that machine, together with the weakening of the spring is the thing that changed Rafter's machines from cutting to tearing devices. If this conclusion of the Trial Court is correct,

then every machine that Rafter produced would vary, for it is not tenable that the dulling and chipping of the discs on different machines would be the same, or that the weakening of each spring on every machine would be the same, or that there would be a uniform lack of uniformity in the discs and washers of each machine. Surely, no patent could ever be issued upon inaccuracy of workmanship in a machine. Surely no patent could be issued upon wearing of the elements and weakening of springs. If no patent could issue upon these things, then Plaintiff urges most sincerely that a patent regularly issued cannot be defeated by claim of prior use of a machine that employs a patented method, wholly and solely because unknowingly the parts thereof had become partially worn out, the springs had weakened, and the individual parts were lacking in uniformity.

It is to be further observed, that if the wearing and weakening of Rafter's machine is the cause of the change in Rafter's machine from a cutting to a tearing machine, then there is no evidence as to the date when this change was accomplished. Accordingly proof of prior use would fail. There is no presumption available to aid the defendant or to assist the Trial Court, in concluding that such change in defendant's machine occurred prior to Plaintiff's invention.

(R 34)

"But the two most important factors which changed Rafter's device into a tearing machine were the application of power and the cutting of news print. The motor was added in August, 1933. From that time it was difficult to make excelsior with straight edges. The speed had to be cut down and thick glazed paper cut in order to attain this result.

From the construction of a sheet of news print, one can readily discern that producing a straight edge on strips cut therefrom is a difficult matter on any device. These inferences from the nature of the operation are fully supported in the testimony."

Mr. Rafter testified with reference to the application of power, as follows: (R. 282) That his machine was turned by hand from about the first of August, 1923, and that the business commenced on the first of August, 1923, and grew until January 1, 1924. That power was applied about the middle of August, 1923. No supportable inference can properly be drawn from such testimony that the application of power changed the character of excelsior manufactured, or the method of manufacture.

Plaintiff does not understand what the Court could have referred to as the second important factor which changed the Rafter device into a tearing machine, when it referred to that factor as "the cutting of newsprint." The undisputed testimony is that newsprint was cut by Rafter's machines from the very inception, on August first. But it was all cut, not torn. Newsprint had been cut and sold as excelsior since 1920. In any event, Plaintiff does not claim newsprint as an ingredient of torn excelsior. The process is claimed on all paper.

(R 34)

"The article in the Seattle paper and the enlargements of the pictures taken of the Rafter machine are cited as evidence to the contrary, but it is clearly shown there that the product fell haphazard, and that the edges were intermeshed and the mass resilient. Some of the strips show roughened edges under the microscope. The use of the expressions "torrent" of strips pouring from the machine, and "cascading" onto the floor below, are typical of Defendant's machine and convince the Court that if the Rafter ma-

chine were operated at that rate of speed the result was shredded paper strips. The reference to cutting of magazines indicates that even at that late date the cutting of straight edged glazed paper was still followed, but it has no way to prove that the device produced no other product."

The Trial Court observed that "some of the newsprint shows torn edges. The majority of the strips have straight edges, and show that they were cut. This establishes the fact conclusively that Rafter's machines as late as March, 1925, were cutting, and not tearing devices. It may be admitted for the sake of argument that when a cutting machine is overfed and overcrowded beyond its capacity, and an amount of paper is fed to it, less than that required to jam or stop it, that a crushing as well as cutting action takes place, and a less clean edge results than from normal feeding. This assumed process, however, is essentially different from the operation of a tearing machine, where the paper is all torn, AND NONE CUT, regardless of the thickness of paper fed.

Hence, the inference of the trial court,

(R 34)

"It is a proper deduction from all of these circumstances that Rafter intended at first to produce excelsior with a straight edge, but owing to the inherent nature of his machine as set out in the application, and his desire for quantity production, he actually made torn excelsior."

is unwarranted, and the facts assumed by the Court do not satisfy the burden placed upon the Defendant to establish the defense of prior use by proof beyond a reasonable doubt.

(R 35)

"As the record is reviewed, it seems clear that he

was entitled to a patent.”

Plaintiff submits from the foregoing analysis of the Court’s opinion, and the contrary testimony, that Rafter was not entitled to a patent. No patent could be obtained. Rafter’s machines in operation did not constitute prior use of the machine and process of Antonsen’s patent.

(R 35)

“But the application did not describe this product specifically. It is questionable as to whether this arose from confusion in his own mind, or from failure to appreciate the qualities of the torn product, or from failure to explain his machine with precision to his attorney.”

The foregoing statements of the Trial Court are contrary to Rafter’s own testimony. Rafter testified that he could read blue prints and shop drawings, that he sat down with his attorney, explained the machine and its product, showed him a sample of the excelsior. That the drawing was made, he examined it, the specifications written, and he read them, and then signed them, and swore to them.

If Rafter could not make himself understood by a sympathetic patent attorney, how could he acquaint the public with it. How is it conceivable that he was able to convince the Trial Court in 1933, that he had another machine and another principal in mind other than that specified in his patent applications of 1924.

If, on the other hand, Rafter was not misunderstood, but himself failed to appreciate what his actual machine has been found to be by the Court, it is inconceivable that such decree of the Court can be permitted to stand, where the Court did not see Defendant’s original machine in its original condition, and had only the testimony of the alleged inventor to guide him, which testimony the Court else-

where in his opinion said is unreliable and the witness thoroughly discredited. It must be borne in mind that if Rafter was misunderstood by the patent attorney who drafted his application, that he then employed additional counsel in 1927 in Detroit, and that these additional attorneys examined his machine, his product and his patent application. The attempt to get a patent proceeded until 1928. The conclusion of the Trial Court that Rafter was misunderstood and failed to explain his machine to his attorney does not seem well founded.

(R 35)

“There can be no doubt that from the outset of the use of power on the Rafter machine to various circumstances the cutting discs moved over into the same relative position as that in which the discs on the Antonsen machine are fixed. While in that position these discs performed exactly the same function which those on the Antonsen machine do now, and the same result was produced as is now obtained on Antonsen’s device. When two devices, however different in form, perform the same functions by virtue of similar elements, for the purposes of the patent law, the devices are themselves identical.”

If the application of power changed the function of Rafter’s machine, then why did Rafter’s patent application, made more than four and a half months after the application of power, not have some reference to the alleged beneficial result of application of power?

Furthermore, in the pleadings, counsel for Defendant did not include any reference to the addition of power to Rafter’s machine as changing that machine, or causing it to operate under the Antonsen process. It does not appear in any testimony. The first time any contention was made by anyone in this case that power changed the process of

the Rafter machine was when the Trial Court suggested that fact in the argument upon the Findings of Fact and exceptions thereto.

The only reference in the testimony to the application of power is in detailing the alleged history by Rafter of the so-called development of his machine. In his patent application and the prosecution thereof for four and a half years, in his testimony on deposition, and in his testimony before the Trial Court, he did not utter one word with reference to any alleged change in his machine or its product by reason of the application of power. That insupportable idea in this case is wholly and solely a creature of the Trial Court's mind.

It is unnecessary to again re-iterate the testimony of the experts and operators of Rafter's machines of how those machines clogged and jammed, and a stoppage occurred when in excess of five or six sheets were fed to the machine. If that testimony is to be believed (and after all, it is the testimony largely of Defendant's witnesses) the Court's conclusion that the cutting discs on the Rafter machine moved over into the same relative position as that in which the discs on the Antonsen machine are fixed, is entirely erroneous and unfounded.

(R 35)

"Antonsen performed two services. He stabilized the discs in the position which they attained in the Rafter machine when operated at high speed and overcrowded. This was a mere mechanical operation. Second, he hired a patent attorney who clearly and correctly described the operation."

It is true that Antonsen stabilized the disc in opposing shaft out of facial contact. There is not the slightest evidence that Rafter knew anything about it. Certainly, he

did not tell about it in his patent application. He performed none of the things prescribed by Congress as entitling him to the reward of an inventor, and even if it were true that he did tear paper excelsior, which it is not, he would be in precisely the same position as the man who first kicked up gold along the trail, but failed to recognize that it was a gold mine.

The Trial Court concluded that placing the discs in separation was a mere mechanical operation. It does appear to be a very simple thing. This is characteristic of inventions everywhere. The Supreme Court in *Diamond R. Company vs. Con. Tire Company*, 220 U. S. 428, stated:

“It possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and ‘in the light of the accomplished results’ it is often a matter of wonder how they so long eluded the search of the discoverer and set at defiance the speculations of the inventive genius.”

It is true that Antonsen hired a patent attorney who clearly and correctly described his machine and method. In doing this, Antonsen should not be criticized, but applauded, since the world has gained by his disclosure.

(R 35)

“Rafter seems not to have appreciated the commercial demand which would result for the manufacture of torn excelsior. But he did make it and manufacture machines which produced it in the hands of others, and thereby created a new industry. He sold the product to the public and operated the device successfully in a public manner. When he abandoned the patent application, this invention be-

came the property of the public and Antonsen is not entitled to monopolize it."

Rafter did not appreciate the commercial demand for *torn* paper excelsior until Antonsen built a machine, and invented the method, and at great expense created a market (R. 78 and 79). Rafter was even later than others in his appreciation, since his own testimony states that he went out of the excelsior business and re-engaged in the same only thirty days before the depositions were taken in Seattle in 1933, long years after those whom he had sold territorial rights to with his original machines had either abandoned those machines or rebuilt them to conform to Antonsen's invention.

The only evidence in this case of the creation of a new industry by Rafter was the sale of seven machines, which the testimony discloses are all out of operation except the Defendant's machine in Portland. The testimony clearly shows that that machine has been changed to employ the tearing method; otherwise, it is fair to assume that that machine would also be out of operation whether the change of Defendant's machine was intentionally or inadvertently made, is immaterial. By design and construction, it originally was a cutting machine. It remained in the excelsior industry because of the alterations adapting it to the tearing method.

It is true that when Rafter abandoned his patent application, the contents thereof became the property of the public. Abandoned applications, however, are kept secret from the public. In any event Rafter's patent application as abandoned contained nothing new in the art of manufacturing paper excelsior, and had it been accessible to the public, they would have gained nothing from it.

(R 35-36)

"The feature of sale to the public and notorious use of the device distinguish this state of fact from cases where a by-product has been made, the use of which is unappreciated. See *Boyd vs. Cherry*, 50 Fed. 279, 283. Likewise it is differentiated from a case where certain phases of a process of reducing ore had been used without appreciation prior to an application for patent therefore. *Carson vs. American Smelting & Refining Co.* 11 Fed. (2d) 766. If the use of these portions of the process had been reflected in the product, the cases would be similar. In the instant case, it was, torn excelsior was manufactured and sold. In the case cited, the metal which was smelted from the ore was just the same no matter how the result was accomplished."

The attempted distinction by the trial court in the cases cited by him, and the instant case on the grounds that the product produced by the process in suit reflected the characteristics of the process of manufacture, does not appear to be sound. Likewise, it does not have authority in law. See *Diamond Patent Company vs. S. E. Carr Company*, 217 F. 400, which case was decided by this Circuit and involved all glass show cases with flexible joints, and which case cites numerous other cases which have adopted the uniform rule in keeping with the rule of *Boyd vs. Cherry*, and *Carson vs. American Smelting and Refining Company*.

It appears that the Trial Court's decision is based upon certain presumptions which the Court cites no authority for the making thereof, and which presumptions appear to be against the facts contained in the testimony, and his decision then continues to be based upon claimed distinctions of fact and law, which facts are not present in this case, and which law is not cited by the Court and is unknown to the Plaintiff if it is to be found.

(R 36)

“Antonsen’s actions are entirely convincing to the court if other proof were lacking. He had old newspapers to dispose of and came to inspect the Rafter’s machine. He became convinced that it was the device he desired and at the same time discovered that Rafter did not entirely know the full potentialities of the product. He said at this time that Rafter had ‘a gold mine and doesn’t know it.’ He purchased the machine for Three Thousand (\$3,000.00) Dollars, together with other things of slight value.”

It is strange that the Trial Court in his summary in the preceding paragraph did not mention the sale by Rafter to Antonsen of territorial rights. Antonsen purchased the machine at that price because it gave him “protection in the territory and some outlet for my paper.” (R. 82)

This territorial protection was sold to others. Foster testified (R. 323) that he purchased the machine from Rafter with the exclusive right to manufacture in Massachusetts. That he then paid Rafter \$500.00 additional for the *right to operate in Connecticut*.

Rafter testified (R. 283)

“I sold a machine to Mr. Wheeler, thirty days later around March, 1924, for the Portland territory. I allocated certain territory to certain machines.”

With this testimony before the Trial Court, the Court’s conclusion that Rafter did not appreciate the commercial importance of paper excelsior seems to be based upon an unsound premise.

Mr. Rafter’s attempt to commercialize the market was abortive because his machines could not operate successfully without change, and alteration. Mr. Henderson testified (R. 300) that he changed his machine in San Francisco, as follows:

"I helped Mr. Rafter adjust the shredding discs on the San Francisco machine. I also had them adjusted again down there. I made a big improvement after that. It was just a little suggestion of my own, took them down to the machine shop and got leather fiber or paper fiber, and cut a lot of little discs to go on the axel where the disc goes on, so as to seperate them so much, to broaden the width."

The testimony of Wheeler and Hedrick of the change made in the Defendant's machine has heretofore been set out. The Foster machine operated unsuccssfully in Boston, we may largely infer because of no change in it. It is fair to infer from all of this testimony that Rafter's machines were unsuccessful on the market, and that Rafter did not create a new industry. That new industry was created when Antonsen developed and commercialized his tearing machine, and the tearing process as shown by his testimony quoted elsewhere in this brief .

(R 36)

"He bought up other machines made by Rafter, with the idea of putting them out of circulation."

Again the Court is mistaken in his statement of the facts. The only other machine bought by Antonsen was Mr. Foster's machine. Plaintiff challenges the accuracy of the Court's statement. Plaintiff further urges that this discrepancy in the Court's statement from the actual facts, and the testimony of the case is indicative of a desire on behalf of the Trial Court to make the Defendant's case appear as strong as possible in his written opinion. The Court's statement just quoted is undoubtedly inadvertent, but after all, is basic so far as the Plaintiff is concerned, because the inference that the Trial Court would draw in his mind where he is carrying in his mind the thought that

Antonsen bought up other *machines* to put them out of circulation when the sole and only testimony in the case is that one other machine was bought up and that for the sole purpose of showing what a true cutting machine of the Rafter type was like.

(R 36)

“He then studied for some plausible differentiation, and finally adopted the solidly fixed discs with uniform separation.”

Plaintiff is unable to discover any testimony whatsoever in this case that would support the foregoing quoted conclusion of the Trial Court.

(R 36)

“This was an improvement over the Rafter machine, but was only such as a trained mechanic would make once he saw torn excelsior made and conceived its further manufacture with less difficulty desirable.”

With cutting machines on the market since 1885, it does seem peculiar that some trained mechanic did not make this so-called apparent improvement.

At the risk of duplication, the Plaintiff desires to again set forth a portion of the Supreme Court opinion in *Diamond R. Company vs. Con. Tire Company*, supra,

“Its simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and ‘in the light of the accomplished results’ it is often a matter of wonder how they so long eluded the search of the discoverer and set at defiance the speculations of inventive genius.”

With reference to the case of *Eibel Process Company vs. Minnesota and Ontario Paper Company*, 261, U. S. 45, the principal element of inventive genius in that case was elevation of the paper making wire chute down which

paper pulp was run, substantially an adjustment only in the pre-existing machinery used in the prior art. If the adjustment in the Eibel case is properly construed, as inventive genius, should it not be held in this case that it is inventive genius for Plaintiff Antonsen to fixedly mount opposite rotating discs in separation with the express object in view to tear multiple layers of paper into narrow strips of excelsior?—to obtain an improved product where all the prior art known to the patent office or the public up to that time consisted of cutting multiple sheets into narrow strips by oppositely rotating discs with their edged sides engaging and in shearing relation? This is especially true in view of the uncontradicted testimony that the adoption of the tearing method resulted in increasing many times over the capacity of former cutting excelsior machines. It resulted in a saving of \$2.00 a ton in the cost of manufacture. It speeded up production. It created a better product, and as shown by the testimony, it developed a new industry.

(R 37)

“Antonsen brought other suits to establish the validity of the patent in localities where the defense of lack of novelty would probably not be raised.”

It is difficult to appreciate the foregoing inference of the Court in view of the fact that the first case brought by Antonsen for infringement was in the City of San Francisco, where Rafter testified he sold and shipped his first machine, the same having been sold to a Mr. Henderson who operated the machine in that city.

The second action by Mr. Antonsen for infringement was brought in Cleveland, Ohio, not far removed from the City of Chicago, and the City of Kansas City, where Raf-

ter testified he sold two of his machines. The third action by Mr. Antonsen for infringement was brought in the City of Spokane, Washington, within a few hours travel of the City of Seattle, approximately the same distance from Seattle as the City of Portland, in which the instant case was brought.

The question of prior use or anticipation could well have been raised in San Francisco. If Rafter's machine operated in that city had been considered as anticipation of Antonsen's invention it surely would have been pleaded as a defense, for that case was stoutly resisted and very bitterly fought. This is likewise true of the cases in Cleveland and Spokane.

It is also difficult to understand the reason for the Trial Court's conclusion when Rafter testified (R. 320) that Antonsen had brought suit against him for infringement because he (Rafter) had engaged in the tearing excelsior business about 30 days before the taking of Rafter's deposition in the instant case, in Seattle, in April, 1933.

(R 36-37)

"Furthermore, of all the persons who saw the Rafter machine in operation when driven by power, Antonsen and two persons who have been employed by him for many years are the only ones who testify that the Rafter machine did not produce torn excelsior."

Plaintiff desires to again observe the attempted distinction by the Court of the Rafter machine with and without power, and to again call attention to the fact that this contention on the part of the Court belongs wholly and solely to the Court, and did not enter into this case until indicated by the Court upon the argument to the exceptions to the Findings of Fact proposed by the Defendant.

There were no references to the question of power in the first findings, but such references appeared for the first time in the findings finally signed by the Court.

In so far as the Court's statement in the preceding paragraph is concerned, about the production of torn excelsior by the Rafter machine, we refer back to the Court's opinion (R. 33) in the following words:

"The machine would cut paper with straight edges."

It should be borne in mind that there is a substantial difference between torn paper excelsior as manufactured by the Antonsen process and the somewhat roughened edges of the excelsior produced by Rafter's machine when that machine was overfed and overcrowded.

To summarize this analysis of the Court's opinion, it may fairly be said that the Court makes the following observations:

1. Rafter designed a machine with cutting discs in facial contact.
2. Rafter intended to make cut excelsior.
3. Rafter's machine cut straight edged excelsior when a few sheets were fed.
4. Rafter's machine that was sold to Foster and examined by Plaintiff's expert, Rockwell, was of this type of construction.
5. Rafter's machine became changed from a cutting to a tearing machine by: a. dulling and chipping of the cutting discs. b. Weakening of the spring. c. Failure to keep the nuts tight. d. Difference in thickness of the washers.
6. Separating the discs in fixed position and out of facial contact is an improvement in the prior art.
7. Antonsen performed the service of fixedly mount-

ing the separated discs.

8. Antonsen correctly stated the mechanical principals and the process involved in the change in February, 1925.

Are not these findings contained in the opinion of the Trial Court in themselves sufficient to establish that Antonsen did invent the machine and process now involved in this suit, and that the defense of prior use in so far as the Rafter machine is concerned has not been established by that degree of proof required by the law?

A comparison of the patent applications of Rafter and Antonsen indubitably establishes that Antonsen fully understood the old and the new machines and methods of manufacturing paper excelsior. Also, that Rafter did not know, understand or appreciate the tearing machine or method and his application teaches the public nothing.

It seems difficult that the Trial Court could reach the conclusion after an examination of such undeniable indisputable evidence, that Rafter was the inventor of the machines and process and that Antonsen stole them from him.

THE LAW

The issues of law in this case naturally divide themselves into four main classifications, as follows:

- I. The burden of proof on issue of prior use.
- II. Prior use must be understood.
- III. Oral testimony on prior use not reliable.
- IV. Invention vs. Mechanical improvement.

Many of the cases cited support more than one of the principal divisions above suggested, but for the sake of convenience of the Court we have undertaken at the expense of repetition, to put the authorities in the classification to which we feel they rightfully belong.

I.

BURDEN OF PROOF ON ISSUE OF PRIOR USE.

The United States Supreme Court has expressed itself and formulated a rule with reference to the burden of proof on issue of prior use. There has been a uniform adoption of the Supreme Court rule by the District and Circuit Courts. The 9th Circuit has adopted the rule in several cases, which are cited herein.

The Barbed Wire Patent, 143 U. S. 275, 284.

“We have now to deal with certain unpatented devices, claimed to be complete anticipations of this patent, the existence and use of which are proven only by oral testimony. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, *courts have not only imposed*

upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt... Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorably to themselves are not usually to be depended upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imaged they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defense of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer. The doctrine was laid down by this court in *Coffin v. Ogden*, 18 Wall, 120, 124, that "the burden of proof rests upon him," the defendant, "and every reasonable doubt should be resolved against him."

Deering v. Winona Harvester Works, opinion by Mr. Justice Brown, 155 U. S. 286, 300.

"This case is an apt illustration of the wisdom of the rule requiring such anticipations to be proven by *evidence so cogent as to leave no reasonable doubt* in the mind of the court, that the transaction occurred substantially as stated."

Eibel Porcess Company vs. Minnesota and Ontario Paper Company, 261 U. S. 45; 67 L. Ed. 523, at page 531, the Supreme Court of the United States, speaking through Chief Justice Taft, said:

“The oral evidence on this point (referring to the question of prior use) falls far short of being enough to overcome the presumption of novelty from the granting of the patent. The temptation to remember in such cases and the ease with which honest witnesses can convince themselves after many years of having had a conception at the basis of a valuable patent are well known in this branch of the law, and have properly led to a rule that *evidence to prove prior discovery must be clear and satisfactory.*” (citing cases)

In *Cantrell vs. Wallick*, 117 U. S. 689, 695; 6 Sup. Ct. 970; 29 L. Ed. 1017,

“the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty. * * * *Not only is the burden of proof to make good this defense upon the party setting it up, but it has been held that ‘every reasonable doubt should be resolved against him.’*”

Parker v. Stebler et al., (C. C. A. 9) 177 F. 210, 212.

“It is well settled that the defense of prior use must be established by *evidence which proves it beyond a reasonable doubt.* The question of novelty is a question of fact. *Turrill v. Michigan Southern R. R. Co.*, 1 Wall. 491, 17 L. Ed. 668. And it has been held that the oral testimony of many witnesses, if

unsupported by any evidence consisting of documents or things, must be very reasonable or very strong to establish the defense of prior use. The Barbed Wire Patent, 143 U. S. 275; 12 Sup. Ct. 443, 450; 36 L. Ed. 154; *Deering v. Winona Harvester Works*, 155 U. S. 286; 15 Sup. Ct. 118; 39 L. Ed. 153."

San Francisco Cornice Company v. Beyrle, 195 F. 516, 518, (C. C. A. 9)

"With respect to the first defense, the rule is that the burden of proof is upon the Defendant to establish this defense, for the grant of Letters Patent is prima facie evidence that the patentee was the first inventor of the device or the discoverer of the art or process, described in the Letters Patent and of its novelty." (citing *Smith vs. Good Year*, 93 U. S. 486, 489; 23 L. Ed. 952, and *Lehnbeuter vs. Holthaus*, 105 U. S. 94, 96; 26 L. Ed. 939).

"Not only is the burden of proof to make this defense upon the very party setting it up, but it has been held that *every reasonable doubt should be resolved against him.*" (citing *Cantrell vs. Wallrick*, 117 U. S. 689, 695; 29 L. Ed. 1017; 6 Sup. Ct. 970).

Diamond Patent Company v. S. E. Carr Company (C. C. A. 9) 217 F. 400, 402. This case was tried before Frank H. Rudkin, Judge of the Northern Division, Eastern District of Washington. The opinion of the C. C. A. was by Judge Gilbert, and in part is as follows:

"(1, 2) The appeal herein presents the single question whether the evidence introduced to prove prior use is in law sufficient to negative the novelty of the

invention. Concerning the nature of the evidence required to establish the defense of prior use, it was said, in *Coffin v. Ogden*, 18 Wall, 120; 21 L. Ed. 821:

“The invention or discovery, relied upon as a defense, must have been complete, and capable of producing the results sought to be accomplished, and this must be shown by the defendant. *The burden of proof rests upon him, and every reasonable doubt should be resolved against him.*”

Wilson and Willard Manufacturing Company et al. v. Bole et al. (C. C. A. 9) 227 F. 607, 609.

“The general rule that a person who attacks the validity of a patent issued to another must make out his case by clear and satisfactory proof, or by *proof beyond a reasonable doubt*, will not be gainsaid. This rule is founded in reason. It presupposes an adjudication by the Patent Office of every fact essential to the validity of the patent, and one who attacks that adjudication in a collateral proceeding must establish his claim by clear and satisfactory proof, or, as is often said, by proof beyond a reasonable doubt.”

The Court's attention is called to the case of *Carson v. American Smelting & Refining Company*, 293 F. 771; 4 F. (2d) 463; 11 F. 2d) 766. This case was tried before Judge Neterer in Seattle, and the process patent was held void because of anticipation.

The decision of the Trial Court was reversed by the Court of Appeals of this Circuit, the opinion being by Judge Gilbert. In its opinion, the Court again emphasized

the rule that anticipation must be established beyond a reasonable doubt. The opinion states:

“In *Deering v. Winona Harvester Works*, 155 U. S. 286, 300; 15 S. Ct. 118; 123 (39 L. Ed. 153) it was said: ‘Oral testimony unsupported by patents or exhibits tending to show prior use of a device regularly patented, is, in the nature of the case, open to grave suspicion’. And the Court confirmed the wisdom of the rule requiring such anticipation to be proven by *evidence so cogent as to leave no reasonable doubt* in the mind of the Court that the transaction occurred substantially as stated.” 4 F. (2d) 468.

Thereafter the appellee filed a petition to re-open the case and be permitted to amend its answer by setting forth prior use of the invention in certain furnaces used by the late Superior Smelting Company at Dollar Bay, Michigan.

This petition was supported by many affidavits. The opinion of the Court, 11 F. (2d) 770, as to the contents of these affidavits, is as follows:

“But if the application here rested *alone* upon the affidavits presented by the appellee, the showing would be insufficient to establish prior use of the invention so as to defeat the patent. In *Gayler vs. Wilder*, 10 How. 477; 13 L. Ed. 504, it was held that the prior use must be so far understood and practiced or persisted in as to become an established fact accessible to the public, and contributing definitely to the sum of knowledge. In *Ajax Metal Company vs. Brady Brass Company (C. C.)* 155 F. 409, 416, it was said: ‘It is incumbent upon the Defendants,

therefore, to show that the prior use which is set up *was so far appreciated at the time and adopted or followed as to create a well understood, if not an established practice, capable at any time of being resorted to, and not something indefinite, incidental and fugitive which is now hunted up and brought forward simply for the purpose of defeating the patent.*' In *Anthracite Separator Company vs. Pollack* (C. C.) 175 F. 108, 111, it was held that prior use, in order to negative novelty, must be something more than an accident or casual one; that the use must have been accessible to the public, and an established fact in the art. It is well settled that the oral testimony of many witnesses, if unsupported by any evidence consisting of documents or things, must be very reasonable or very strong to establish the defense of prior use. *The Barbed Wire Patent*, 12 S. Ct. 450; 143 U. S. 275; 36 L. Ed. 161; *Deering vs. Winona Harvester Works*, 15 S. Ct. 118; 155 U. S. 286; 39 L. Ed. 153.

"In the *Barbed Wire Patent* case, Mr. Justice Brown said: '*The frequency with which testimony is tortured or fabricated outright to build up the defense of a prior use of the thing patented goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer.*'

"In *Kalamazoo Loose Leaf Binder Company vs. Wilson Jones L. L. Co.* (D. C.) 286 F. 715, 717, Judge Hand said: 'I think the proof scarcely comes up to the severe standard imposed in such cases. There is no documentary corroboration of it, and the testimony of the witnesses, though unimpeached, is not supported by any circumstances which put it be-

yond the inevitable infirmities of their recollection. The most recent declaration of the Supreme Court in *Symington vs. National Castings Company*, 39 S. Ct. 542; 250 U. S. 383; 63 L. Ed. 1045, shows no disposition to relax the well-established canon.'

"The question whether or not the appellee should have leave to apply to the court below for permission to file a bill of review must be decided upon the showing made upon the affidavits (*Suhor vs. Gooch*, 248 F. 870, 160 C. C. A. 628), and permission in such a case will be denied unless the evidence is so controlling that it would probably induce a different conclusion from that on which the decree was based."

Ward Baking Company v. Hazelton Baking Company (D. C. M. C. Pennsylvania) 292 F. 202, 204.

"The burden of disproving validity rests with those preferring the charge. The grant of the patents carries with them the presumption of their validity. The prima facie of validity is so strong that the burden of proof upon a defendant to establish defenses that attack the validity of a patent is the *same as that upon the prosecution in a criminal case*. Courts are not permitted, therefore, to constitute themselves into a board of reviewing examiners and on nicely balanced considerations find that the patent office examiners were in error. The grant of the patent carries with it the respect due a contract made on behalf of the government by those expert and authorized to act for it in honesty and good faith, and unless proof is forthcoming carrying conviction beyond reasonable

doubt to the contrary, its validity will not be impeached. In the light of these observations, the charge of invalidity must be met."

PART II.

PRIOR USE MUST BE UNDERSTOOD

The Barbed Wire Patent, 143 U. S. 275, 284,

"*'If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view.'* This case was subsequently cited with approval in *Cantrell v. Wallick*, 117 U. S. 689, 696, and its principle has been repeatedly acted upon in the different circuits. *Hitchcock v. Tremaine*, 9 Blatchford 550; *Parham v. American Button-Hole Machine Co.*, 4 Fisher 468; *American Bell Telephone Co. v. Peoples' Telephone Co.*, 22 Fed. Rep. 309."

Diamond Patent Company v. S. E. Carr Company (C. C. A. 9) 217 F. 400, 402.

"In *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504, it was held that the *prior use must be so far understood and practiced or persisted in as to become an established fact, accessible to the public and contributing definitely to the sum of knowledge*. Cases applying these rules are *Acme Flexible Clasp Co. v. Cary Mfg. Co.* (C. C.) 96 Fed. 344, *Anthracite Sep-*

arator Co. v. Pollock (C. C.) 175 Fed. 108, Ramsay v. Lynn, (C. C.) 187 Fed. 218, and Ajax Metal Co. v. Brady Brass Co. (C. C.) 155 Fed. 409. Under the rule established by these decisions, we are required to view with caution and careful scrutiny evidence which is introduced to show a prior use that destroys the pecuniary value of a patent, which has met with commercial success and has been of value to the community."

Beckwith v. Malleable Iron Range Co., (C. C. E. D. Wisconsin) 175 F. 1001, 1010.

"Thus it appears that the convex protuberance on defendant's prior structures, the Weiser, Drawn, and Hicks ranges, was simply accidental. It attracted no attention and was considered a matter of no significance until Beckwith made this feature an important element in his combination. The law is well settled that such prior accidental production, when the character and function were not recognized until the patented invention came into being, cannot be relied upon by way of anticipation. Walker on Patents (4th Ed.) 67; Wickelman v. Dick Co., 88 Fed. 264, 266, 31 C. C. A. 530; Tilgham v. Proctor, 102 U. S. 707, 711, 26 L. Ed. 279; Pittsburg Reduction Co. v. Cowles Co. (C. C.) 55 Fed. 301; Chase v. Fillebrown (C. C.) 58 Fed. 377.

Looking backward, several stovemakers now see how nearly they approached the consummation finally reached by Beckwith; but none of them hit upon the coacting law by means of which these three elements were combined to produce new and practical results so

long sought. Their unsuccessful efforts in the art cannot now defeat a patent founded upon a readjustment of materials by which new and useful results have been brought about. *Edison El. Co. v. Novelty Co.*, 167 Fed. 977, 980, 93 C. C. A. 387."

Ajax Metal Company vs. Brady Brass Company, (C. C. D. New Jersey) 155 F. 409, 415.

"There can be no question, under the evidence, that at the date stated the Brady Metal Company did make a journal composed of copper, tin, and lead in the proportions suggested. *This is proved by documentary evidence which cannot be controverted, the original letters from the metallurgical chemists who made the analysis having been produced*, where the copper is given at 65.29 per cent., the tin at 7.54 per cent, and the lead at 26.56 per cent., with traces of zinc and iron which are not material, the percentage of tin being subsequently corrected and reduced to 5.93, by taking out the antimony which had been inadvertently included. But while a single previous knowledge or use, such as this, may be enough to negative novelty, (*Coffin v. Ogden*, 18 Wall. 120, 21 L. Ed. 821; *Daniel v. Restein* (C. C.) 131 Fed. 469), the use must be something more than an accidental or casual one (*Tilghman v. Proctor*, 102 U. S. 707, 26 L. Ed. 279). *It must, indeed, be so far understood and practiced or persisted in as to become an established fact, accessible to the public and contributing definitely to the sum of human knowledge.* *Gayler v. Wilder*, 10 How. 477, 497, 13 L. Ed. 504; *Acme Flexible Clasp Co. v. Cary Mfg. Co.* (C. C.) 96 Fed. 344. It is in-

cumbent on the defendants, therefore, to show that the prior use which is set up was so far appreciated at the time, and adopted or followed, as to create a well-understood, if not an established, practice, capable at any time of being resorted to, and not something incidental, indefinite, and fugitive, which is not hunted up and brought forward simply for the purpose of defeating the patent. It is just here that the use by the Brady Metal Company, which is relied upon, is challenged, and is open to question."

Chisholm et al. v. Randolph Canning Co., (C. C. Wisconsin) 135 F. 815, 816.

"While it is true that the resemblance in the general form of the machines is striking, it is obvious from the descriptions given by Mme. Faure that she had no conception of the impact method which was discovered by the Chisholms. As it now appears that her device is incapable of its practical performance, I am of opinion that it constitutes no bar to the claims of invention in the Chisholm patent.' "

Chisholm et al. v. Fleming et al. (C. C. Delaware) 133 F. 924, 926.

"There is a general similarity in point of appearance between the Faure machine and the machine of the patent in suit; but with respect to the adjustment and characteristics of the working parts of the two machines, determinative of the nature of the process carried on by them, there are marked and important differences, producing different results. It may be well here briefly to refer to some of these differences.

In the machine of the patent in suit, or Chisholm podder, there is a clearance of an inch or more between the tips of the beaters and the faces of the counter-beaters or lifting ribs. In the Faure machine the clearance is only three eighths of an inch. By reason of this difference, while green peas can be hulled only by impact in the Chisholm machine, the pods can and necessarily must be abraided in the Faure machine to the extent to which they are caught between the tips of the beaters and the faces of the counter-beaters."

It is interesting to note that in the case of *Chisholm v. Johnson*, 106 F. 191, the patent on the process of hulling peas by impact was upheld against one of the defenses set up, to-wit: That the patent in suit was anticipated by a French patent. The Circuit Court of Appeals (115 F. 625) reached the conclusion that the patent in suit was void because of anticipation. A dissenting opinion by Judge Gray was filed in that case, which in part is as follows:

"It does not appear in evidence that the thought of hulling peas by impact had ever occurred to her (French patentee) and the machine of her patent was built to act in a different way, that was to hull peas by attrition and abrasion. One who accomplishes a result by a process which is only partially, or not at all understood by him, has invented nothing, and cannot deprive another who afterwards discovers and proclaims the true principle of the operation, of the right of an inventor."

This dissenting opinion was followed in three later cases, *Chisholm v. Flemming*, 133 F. 924; *Chisholm v. Rud-*

olph Canning Company, 135 F. 815; both of which are cited hereinabove, and in the case of *Chisholm v. Canastota Can Company*, 135 F. 816. In all three of these cases the Chisholm patented process for hulling peas was upheld and that the French patent did not constitute anticipation.

Boyd v. Cherry, (C. C. Iowa) 50 F. 279, 282.

“It only remains to consider the defense of prior use. The proof undoubtedly shows that, before the date of Cooley’s invention, several other persons had been in the habit of occasionally submerging vessels containing milk during the process of raising cream therefrom, and in some instances, at least, such use was public. But it also clearly appears that *none of these persons proceeded so far as to discover the utility of the process, or were aware of the fact that by it the important and valuable results since achieved by Cooley could be secured.* It is beyond doubt that Cooley was the first to discover and to make known to the public the fact that by this process the cream could be raised in a much shorter period of time than by any other known means, and that by it a better quality of butter was to be secured at a reduced cost. The others doubtless came very near to this discovery, but they overlooked it, as is apparent from the fact that no other one of them thought enough of the process to permanently adopt it, or to apply for a patent upon it, until after the Cooley patent had come into use and its great utility had been demonstrated. It follows that the controlling question upon this branch of the case is whether it is necessary for the *defendant, in order to sustain the defense of prior use, to show cause, not*

only that the process was publicly used before Cooley's discovery, but that it was so used by some person or persons who perceived the fact of its utility, and who knew what could be accomplished by it, and who communicated this information to the public.

But, upon authority and upon principle, I am constrained to answer this question in the affirmative. In *Tilghman v. Proctor*, 102 U. S. 711, the supreme court, through Mr. Justice Bradley, held an alleged prior use not sufficiently proved, for the reason, among others, that the result had been accidentally and unwittingly produced, while the operators were in pursuit of other and different results, without exciting attention, and without its even being known what was done, or how it had been done. In *Pelton v. Waters*, 7 O. G. 426, the rule is distinctly recognized that the prior discoverer or inventor must have had such a conception of the invention as would enable him to give it to the public. Said Emmons, speaking of the alleged prior inventor in that case, "he not only did not give and could not give it (the invention) to the public, but he did not possess it himself." The same rule is recognized in *Andrews v. Carman*, 9 O. G. 1011, where it is declared, in effect, that the person "who first discovers the principle, and by putting it into practical and intelligent use first makes it available to man," is the first inventor.

If the alleged prior use of the process was under such circumstances that the public obtained no knowledge of the mode of its operation, or of the results to be attained by it, there is no prior use, within the meaning of the patent law.

“In other words, if the parties who made the combination, although seeing with the eye perceived not, and hearing with the ear understood not, * * * they added nothing to their own stock of knowledge; and the fact, if observed by other men, (if they understood it not) added nothing to the science on that subject. Therefore the invention was not made until the parties contriving, or others observing, the existing combination, saw that it could be made available for the purpose of producing a result similar to the one which the plaintiffs have mentioned in their specification.”
Ransom v. Mayor, 1 Fish. Pat. Cas. 267.”

Carson v. American Smelting & Refining Co., (C. C. A. 9) 11 F. (2d) 766, 771.

“(1, 2) But, if the application here rested alone upon the affidavits presented by the appellee, the showing would be insufficient to establish prior use of the invention so as to defeat the patent. In *Gayler v. Wilder*, 10 How. 477, 13 L. Ed. 504, it was held that the prior use must be so far understood and practiced or persisted in as to become an established fact, accessible to the public and contributing definitely to the sum of knowledge. In *Ajax Metal Co. v. Brady Brass Co.* (C. C.) 155 F. 409, 416, it was said: “It is incumbent on the defendants, therefore, to show that the prior use which is set up was so far appreciated at the time, and adopted or followed, as to *create a well-understood, if not an established, practice, capable at any time of being resorted to, and not something incidental, indefinite, and fugitive*, which is now hunted up and brought forward simply for the purpose of de-

feating the patent.” In *Anthracite Separator Co. v. Pollock* (C. C.) 175 F. 108, 111, it was held that prior use, in order to negative novelty, must be something more than an accidental or casual one; that the use must have been accessible to the public and an established fact in the art.

There is nothing in the proof offered by the appellee to show that any person other than the appellant ever conceived the idea of dispensing with fettling by banking the ores against the furnace sides. If any other person conceived that idea his conception is not shown to have been made known to anyone, or in any way disclosed to the public as an improvement or otherwise. *If the furnaces were in fact operated in the manner asserted by the appellee, it must have been done without any conception of the inventive idea which underlies the patent.* It is not even hinted that such operation was recognized as a discovery, or as a new operation or an improved operation, or as anything different from that which had gone before.”

Anthracite Separator Co. v. Pollock et al. (C. C. M. D. Pennsylvania) 175 F. 108-111.

“Even if it was partially appreciated while it lasted, and the possibilities residing in it recognized, the operative principle does not appear to have been *understood, so as to be intelligently reproduced.* A prior use, in order to negative novelty, must be something more than an accidental or casual one. It must, in-

deed, be so far understood and practiced, or persisted in, as to contribute to the sum of human knowledge and be accessible to the public, becoming an established fact in the art. *Gayler v. Wilder*, 10 How. 477, 497, 13 L. Ed. 504; *Tilghman v. Proctor*, 102 U. S. 707, 26 L. Ed. 279; *Acme Flexible Clasp Company v. Carey Manufacturing Company (C. C.)* 96 Fed. 344; *Ajax Metal Company v. Brady Brass Company (C. C.)* 155 Fed. 409. There is not the remotest approach to anything of that kind here. No doubt, as already stated, *there was a conforming structure, with a somewhat similar function, and looking back with the light which we now have we are able to see that the parties had the device of the patent almost, if not quite, in hand.* But they did not follow it up, as they should, and, stopping short where the present inventor went on, it cannot be brought in now to anticipate and defeat what he has successfully achieved by himself."

PART III.

ORAL TESTIMONY ON PRIOR USE NOT RELIABLE

It will be noted that in many of the cases cited in this classification, the Court in its opinion refers only to oral testimony as being insufficient, although there was before the Court in evidence either models as approximate copies of alleged anticipating devices or letters tending to verify the oral testimony or portions of original devices attached to and a part of complete models of the alleged anticipating device. It will be observed that notwithstanding such physical evidence was before the Court, the opinion refers to the same only as oral testimony.

This is especially pointed out because in the instant case

alleged samples of old excelsior were introduced, but identified as authentic only by the witness producing the same, is not authenticated within the exhibit itself. This is further important, in that, in the instant case, the Trial Court in his opinion presumes that the present Defendant's machine in its mechanical condition at the time of trial was the same as when it was originally manufactured by Rafter approximately nine years prior to the date of trial.

Deering v. Winona Harvester Works. Opinion by Mr. Justice Brown, 155 U. S. 286-300.

“Taking this evidence together, it falls far short of establishing an anticipation with that certainty which the law requires. As we have had occasion before to observe, *oral testimony, unsupported by patents or exhibits, tending to show prior use of a device regularly patented is, in the nature of the case, open to grave suspicion.* The Barbed Wire Patent, 143 U. S. 275. Granting the witnesses to be of the highest character, and never so conscientious in their desire to tell only the truth, the possibility of their being mistaken as to the exact device used, which, though bearing a general resemblance to the one patented, may differ from it in the very particular which makes it patentable, are such as to render oral testimony peculiarly *untrustworthy; particularly so if the testimony be taken after the lapse of years from the time the alleged anticipating device was used.* If there be added to this a personal bias, or an incentive to color the testimony in the interest of the party calling the witness, to say nothing of downright perjury, its value is, of course, still more seriously impaired.

“The very exhibit produced by the witness Heller contradicted, so far as it could contradict, his testimony, and the witnesses who ought to have corroborated his story, gave a versoin which showed it to be untrue in more than one important particular.”

Carson v. American Smelting & Refining Co., 4 F (2d) 463, 468.

“The evidence of such prior use consists wholly of the oral testimony of witnesses given 18 years after the event. It is unaccompanied by writing, drawing, model, or kindred exhibit, or physical evidence of any kind.”

Parker v. Stebler et al., (C. C. A. 9) 177 F. 210, 212.

“In the present case no physical evidence of the Ruggles invention is produced in evidence save a truck which was made for use in evidence, *constructed from memory seven years after the original truck had disappeared from view*. The irons which are produced and which *were taken from the first experimental truck* made by Ruggles cannot be said to furnish physical evidence of his invention, for only a portion of those irons was produced, and those which were produced obviously could not be used, fashioned as they are, in the device which is exhibited as the Ruggles invention. In *Cantrell v. Wallick*, 117 U. S. 689 6 Sup. Ct. 970, 29 L. Ed. 1017, the court said: “The burden of proof is upon the defendants to establish this defense. For the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty.”

And in the Barbed Wire Patent Case the court said: "The frequency with which testimony is tortured or fabricated outright, to build up the defense of prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer."

In brief, the *courts have recognized the rule that the oral testimony of witnesses speaking from memory only in respect to past transactions and old structures claimed to anticipate a patented device, physical evidence of which is not produced, is very unreliable, and that it must be so clear and satisfactory as to convince the court beyond a reasonable doubt before it will be accepted as establishing anticipation.* Knickerbocker & Co. v. Rogers, (C .C. 61 Fed. 297; Pratt et al. v. Sencenbaugh et al. (C. C.) 64 Fed. 779; Wickes v. Lockwood (C. C.) 65 Fed. 610; Singer Mfg. Co. v. Schenck (C. C.) 68 Fed. 191; Emerson Electric Mfg. Co. v. Van Nort Bros. (C. C.) 116 Fed. 974; Pettibone, Mulliken & Co. v. Penn. Steel Co. (C. C.) 133 Fed. 730."

Nilson et al. v. Ford Motor Co., 38 F. (2d) 1001, 1002.

"(4) 2. In cases such as this, where witnesses are testifying to events long past, oral testimony unsupported by documentary or other physical evidence is open to grave suspicion for the reasons set forth in the following authorities: The Barbed Wire Patent, 143 U. S. 275, 284, 12 S. Ct. 443, 36 L. Ed. 154; Deering v. Winona Harvester Works, 155 U. S. 286, 300, 301, 15 S. Ct. 118, 39 L. Ed. 153; National Hollow B. B. Co. v. Interchangeable B. B. Co. (C. C. A.) 106 F 693, 703.

PART IV.

INVENTION V. MECHANICAL IMPROVEMENT

It will be observed that the Trial Court in his opinion stated that Plaintiff performed a service which consisted of an improvement in the prior art of shredding paper, but added that it was such an improvement as any trained mechanic would make. The following citations take issue with Judge Fee, and establish a different rule.

Ward Baking Company v. Hazelton Baking Company
(D. C. M. C.) Pennsylvania) 292 F. 202, 204.

106 F. 693, 703."

· "It cannot be said from the comparison observed between the uses made of the oxidizing persulphates and bromate that the effects produced are the same as applied to the same subject-matter and thus constitute chemical equivalents. And for the same distinguishing results in the comparisons made between the uses, if the chemicals mentioned should be regarded as substitutions, *there being new properties and results developed in the art of bread making, it cannot be said that such results would have been obvious to those skilled in the art of bread making.* In the substitution of fusil oil for alcohol as a solvent of camphor in conjunction with nitrocellulose in the manufacture of pynoxyline, thereby giving a better result than the menstrum previously used, and at less expense, the court said:

"The fact that alcohol has been used for many years as a menstrum, when a cheaper solvent could have been used, and would have been, if the availability of fusil oil as a substitute had been obvious to those skilled in the art, *is inconsistent with the sugges-*

tion that nothing but the mere exercise of judgment was involved in selecting it as a substitute." *Celluloid Co. v. Amer. Zylonite Co. (C. C.)* 35 Fed. 301."

In the case of *Diamond Rubber Company vs. Consolidated Tire Company*, 220 U. S. 428, the Court held:

"It possesses such amount of change from the prior art as to have received the approval of the patent office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and 'in the light of the accomplished result' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' *Pearl vs. Ocean Mills*, 2 Bann. and Ard., 469, Fed. Cas. No. 10, 876, 11 Off, Gaz. 2. Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any. And expert witnesses may be brought forward to show that the new thing which seems to have eluded the search of the world was always ready at hand, and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty. The acceptance and utility of change as a further evidence, even as demonstration."

In the case of *Expanded Metal Company vs. Bradford*, 214 U. S. 366, the Supreme Court of the United States held:

“It is suggested that Golding’s improvement, while a step forward, is nevertheless only such as a mechanic skilled in the art, with the previous inventions before him, would readily take; and that the invention is devoid of patentable novelty. It is often difficult to determine whether a given improvement is a mere mechanical advance or the result of the exercise of the creative faculty amounting to a meritorious invention. The fact that the invention seems simple after it is made, does not determine the question; if this were the rule, many of the most beneficial patents would be stricken down.”

CONCLUSION

From the foregoing analysis of the evidence, of the Court's opinion and of the law, Plaintiff respectfully submits that the Trial Court erred in voiding Plaintiff's patent, and in failing to hold Defendant liable for infringement of the machine and process, Claims 1, 2 and 7 of Plaintiff's patent in suit.

The Trial Court erred in lessening the degree of Defendant's burden of proof to establish prior use. Prior use must be established beyond a reasonable doubt. The case of *Lee vs. Upson & Hart Co.*, (C. C. D. Connecticut) 43 F. 670, 671, cited by Judge Fee is distinguishable on its facts from the instant case. The very illustration used in the opinion of the Lee case serves to distinguish it. The Court in the Lee case said:

"It was not a mystery to them. If the improvement had been a complex mechanism, if the essence of the invention had been the nice adjustment of parts to produce a result, or if the thing to be done required genius of a superior order, the testimony would have been insufficient, but it requires much less testimony to satisfy a court that the Messrs. Hart, who had brazed, and welded, and but-welded, for years, conceived and carried out the idea of but-welding instead of brazing the inclined end lips of a blank, than it would to satisfy a court that they had made a new and complicated machine."

In the instant case, Rafter was new in the excelsior business, in fact his supposed invention was made in the first month of his first experience with excelsior machines. His was a complicated machine—especially for a novice

in the excelsior manufacturing business. Plaintiff insists that invention by Rafter was not probable, but highly improbable.

If Rafter's machines did weaken and wear, so that as the Court found, they accidentally and unknowingly produced some rough edged excelsior, such result was unintentional and was not appreciated or perceived. If this did happen, no knowledge was added to the prior art.

In conclusion, it must be said that the defense failed to establish that such worn out condition occurred prior to Plaintiff's invention—therein the defense failed to establish its case by even the preponderance of evidence, not to mention proof beyond a reasonable doubt.

The decree should be reversed, and an accounting ordered.

Respectfully submitted,

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